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BOARD OF PATENT APPEALS  
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TC 3700 MAIL ROOM

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Maa, Shalong

Application No.: 08/833,342

Art Unit: 3721 / 3713

Filing Date: April 4, 1997

For: Computer-Controlled Talking Figure Toy with Animated Features

Box - Office of Public Record  
Attn: B. Fenwick, Supervisor  
Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

I. PAPER MISSING

1. The undersigned Applicant submitted, on 12/17/2000, via First Class Postal Mail, a correspondence (EXHIBIT A) for requesting Certified Copies of File Wrapper and Paper Contents, under 37 C.F.R. §1.59(c), 1.19(b)(2), for the above-identified patent application, with a payment of \$150.<sup>00</sup> enclosed therein. Said correspondence is deemed missing according to Applicant's teleconference with the Q. C. Specialist on 02/16/2001 (EXHIBIT D).

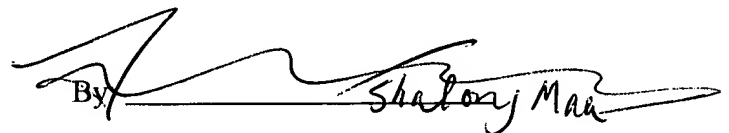
2. However, it appears that said correspondence has been recorded in the Office, since the self-addressed postcard enclosed therein has been returned to the Applicant (EXHIBIT A). Thus, Applicant respectfully requests that the Supervisor review the Office record and have said payment returned to Applicant should it be recovered. [Note: Applicant has authorized the Q. C. Specialist to charge all required fees to Applicant's credit card account submitted (EXHIBIT D) ]

II. PAPER RECORDATION

3. Applicant's second Request for Certified Copies of File Wrapper and Paper Contents, under 37 C.F.R. §1.59(c), 1.19(b)(2), was submitted on 01/10/2001 via First Class Postal Mail (EXHIBIT B-C). However, the entire original correspondence, including the envelop, the signed original statement for requesting certified copies, and a (second) payment of \$150.<sup>00</sup>, are returned to the Applicant (EXHIBIT B).

4. It is Applicant's understanding that the Office should maintain all written communication (other than partial payment of fees required) from the Applicant for a pending patent application, especially those legally submitted under a specific provision of Patent Rules or Title 37, instead of returning the original paper submitted back to the Applicant without written request therefore. Thus, copies of all paper items submitted on 01/10/2001 (EXHIBIT B) are hereby resubmitted for the purpose of Office recordation for the above-identified application, and such action is respectfully requested.

Respectfully submitted,

By   
SHALONG MA  
(Print name of person signing)

Date: 02/19/2001  
SMA International, Inc.  
816 McDeavitt Dr., 1077  
Arlington, TX 76011  
(817) 795-3526

P.S. This correspondence is to be submitted via both facsimile and First Class Postal Mail.



Art Unit: 3721

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

The brief contains a statement identifying that there are no related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

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**(6) Issues**

The appellant's statement of the issues in the brief is substantially correct. There are only three issues:

- a.) Whether claims 35, 37, and 43 are properly rejected under 35 U.S.C. 102(e) as being anticipated by TONG.
- b.) Whether claims 36 and 38-42 are properly rejected under 35 U.S.C. §103(a) as being unpatentable over TONG.
- c.) Whether claims 44-60 are properly rejected under 35 U.S.C. 103(a) as being unpatentable over TONG as applied to claims 36 and 38 above, and further in view of GASPER ET AL.

The three issues listed above are shown on page 3 of Appellant's Appeal Brief as items (6.3), (6.4), and (6.5).

Appellant also lists on page 3 of his Appeal Brief two issues for which this Appeal Brief is not the proper avenue of redress:

- “(6.1) Applying authorities such as MPEP and prior case law as basis for interpretation of statutes and as source of supporting rationale - Errors in Rejections;
- (6.2) Answer all material traversed by Applicant - Errors in rejection and in rationale in support thereof;”

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The issues listed by Appellant as (6.1) and (6.2) are only pertinent to this Appeal where they relate to Appellant's appeal of the rejection of claims 35-60. The specific arguments made by Appellant are discussed regarding these issues are identified specifically below in Section (11).

**(7) *Grouping of Claims***

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with. All of claims stand or fall together since they are not independently patentable.

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,636,994

TONG

6-10-1997

5,111,409

GASPER ET AL

5-5-1992

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**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

- a.) Claims 35, 37, and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by TONG.
- b.) Claims 36, 38-42 are rejected under 35 U.S.C. §103(a) as being unpatentable over TONG.
- c.) Claims 44-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over TONG as applied to claims 36 and 38 above, and further in view of GASPER ET AL.

The above referenced rejections are set forth in prior Office Action, Paper No. 22 and are reprinted below for convenience:

- a.) Claims 35, 37, and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by TONG. TONG discloses an interactive, computer-controlled doll, as described in the previous Office Action, in which actuators to move the doll's body parts. TONG discloses providing a signal from the computer to the doll, which in turn moves the appropriate parts of the doll (mouth, arms, etc.) depending on whether the signal is present or not. Note that while the information within the signal is analog data, the dolls actuators respond to the presence or lack of the signal, taking not the audio data within, but the presence of the signal itself as a logic signal.

TONG also discloses (in embodiment in Fig. 6) a voice-recognition feature where the user can speak into a microphone and the computer will recognize the words and provide the appropriate signal(s) to the doll. (See TONG columns 2-4 and figures 1, 6.)

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b.) Claims 36 and 38-42 are rejected under 35 U.S.C. §103(a) as being unpatentable over TONG. TONG discloses the claimed invention except for the actuators being comprised of a "solenoid means".

However, Applicant is given Official Notice that the use of solenoids as actuators for the movement of dolls and figures is well known in the art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to connect two-phase solenoids as the actuators in the invention of TONG in order to reduce the complexity and cost of the actuators and the invention.

c.) Claims 44-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over TONG as applied to claims 36 and 38 above, and further in view of GASPER ET AL.

TONG substantially discloses the claimed invention except for specifically describing the "digital animation-control signal sequence being associated with selected audio speech ... and transmitted to the toy in synchronization with the transmission".

GASPER ET AL discloses a system for sound-synchronized animation for use in a game, as described in the previous Office Action. GASPER ET AL builds and saves its own dictionary file after determining the proper lip synchronization of an inputted word. GASPER ET AL also teaches different articulations for various sounds: silence, vowels, and consonants.



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It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the method of sound analysis used in GASPER ET AL in the invention of TONG in order to efficiently and accurately analyze and coordinate the inputted user sounds with the movement signals sent to the doll of TONG.

Examiner also notes that TONG does disclose the use of voice-recognition software to analyze inputted voice data. Examiner also notes that it is a standard programming technique to store inputted data of all types, including voice recognition data, in memory arrays for temporary use and in text files for permanent storage and later retrieval.

***(11) Response to Arguments***

In Appellant's Brief page 4, Part VIII.1, Paragraph 1A, Appellant alleges that the Examiner rejects the claims "without source of supporting rationale, such as applying case law or citation of authorities". However, the Examiner has given supporting rationale regarding the rejections in the form of explanations of how the claims in the instant application read on the prior art and how the prior art anticipates or teaches and makes obvious the claims in the instant application. Those rejections and explanations are reprinted above for convenience.

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In Appellant's Brief page 4, Part VIII.1, Paragraphs 1B-1D, Appellant is apparently requesting a discussion of the legal precedents regarding the case. However, the Examiner has made the rejections based on the claims and the prior art, relying on the claimed structure and function of the invention, not on legal arguments, except where appropriate (such as where they are provided by the official Form Paragraphs.)

In Appellant's Brief pages 5-7, Part VIII.2, Paragraphs 2A1-2E2, Appellant appears to be again alleging that the Examiner gave no reason or explanation of the rejection of the claims in the instant application. Examiner maintains that this is not so and refers the Appellant again to the most recent statement of the rejections, reprinted above for convenience.

In Appellant's Brief pages 7-8, Part VIII.3, Section 8.3A (entire) and Section 8.3B, Appellant appears to be narrating his response to the Examiner's First Action on the Merits Paper No. 3), where the Examiner mistakenly referenced 102(b) instead of the correct 102(e) in the rejection of some of the claims. Examiner regrets the angst this has caused the Appellant but the mistake is irrelevant now, since the present rejection of claims 35, 37, and 43 is made clearly under 35 USC 102(e).

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In Appellant's Brief pages 8-9, Part VIII.4, Sections 8.3A (entire) and Section 8.4B, paragraphs B1-B2i, Appellant argues that the elements of claims 35, 37, and 43 are not anticipated by TONG. However, TONG shows the following:

<b><u>Claim 35</u></b>	<b><u>Tong</u></b>
"Actuation means"	shown in TONG as motors (27, 28)
"situated within said body"	shown in TONG as (23)
"operable by an external digital animation-control signal"	in TONG the signal comes from CPU (12) and Sound Processor (18)
"said actuator having only two phases..."	in TONG the solenoid responds to the presence or absence of the signal, so there are only two phases (See TONG columns 2-4 and figures 1 and 6)
<b><u>Claim 37</u></b>	<b><u>Tong</u></b>
"situated within said body"	shown in TONG as (23)
"operable by an external digital animation-control signal"	in TONG the signal comes from CPU (12) and Sound Processor (18)
"and operable by the external digital animation-control signal"	in TONG the signal comes from CPU (12) and Sound Processor (18)
<b><u>Claim 43</u></b>	<b><u>Tong</u></b>
"said external digital control signal sequence includes a second digital control signal sequence"	TONG discloses using multiple control sequences for moving the eyes, the mouth, and doing so repetitively
"actuation means includes a first and a second actuators"	shown in TONG as motors (27, 28)
"for causing independent movements of said two movable portions"	shown in TONG as (24, 26)

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In Appellant's Brief page 9, Part VIII.4, Section 8.4B, Paragraph B2-ii - Paragraph B3, Appellant appears to be restating arguments and allegations that have been addressed above.

In Appellant's Brief pages 10-11, Part VIII.5, Section 8.5A, Paragraph A1 - Paragraph A3b, Appellant states that he submitted a list of "five (5) different superior properties and functions claimed in the invention" but the Examiner "fails to state under what circumstances the presence of superior properties and new functions would be 'not sufficient to prove non-obviousness'" and fails to discuss why Applicant's citation of authority does not support Applicant's traverses.

However, in the Final Rejection of the CPA (Paper No. 2), the Examiner stated:

21. Applicant states on page 7 sections 8.6 and 8.7 of his Response that "It is understood that presence of a superior property or property not possessed by the prior art or unexpected or greater than expected result are evidence of non-obviousness. ... In addition, absence of a property which the present invention would have been expected to possess on the teachings of the prior art also renders unobviousness [sic] of the invention. However, while this two concepts provide evidence of non-obviousness, they are not always sufficient to prove non-obviousness. More importantly, Applicant has not shown any unexpected results, superior properties, or absent properties which would obviate the rejections detailed in paragraphs 3-6 above.

The list of "five (5) different superior properties and functions claimed in the invention" given by the Appellant is little more than a restatement of the properties of the instant invention disclosed

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in the Specification. The Examiner explained in the rejection of the relevant claims how the claims in the instant invention read on the prior art. Appellant's list of "five (5) different superior properties and functions claimed in the invention" have thus already been addressed.

Regarding Appellants contention that the Examiner "fails to state under what circumstances the presence of superior properties and new functions would be 'not sufficient to prove non-obviousness'", the Examiner suggests that Appellant is trying to place the burden of finding superior or unexpected properties of the invention with the Examiner instead of finding them himself.

In Appellant's Brief page 11, Part VIII.5, Section 8.5A, Paragraph A4a - Paragraph A4c, Appellant cites legal precedent that he alleges removes the suggestion to combine from the rejection of the claims in his own application. Examiner notes that Appellant does not specifically address which combination he is referring to, however, Examiner maintains that the suggestion to make the combination or modification for both 103(a) rejections is clear and is reprinted in section (9) above for convenience.

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In Appellant's Brief pages 11-12, Part VIII.5, Section 8.5A, Paragraph A5a - Paragraph A5c, Appellant argues that "TONG does not teach nor suggest any digital 'animation-control' signal or any other type of control signal" and "the electronic devices employed in TONG .. do not facilitate conventional digital control of a solenoid." However, Examiner maintains that

"the use of solenoids as actuators for the movement of dolls and figures is well known in the art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to connect two-phase solenoids as the actuators in the invention of TONG in order to reduce the complexity and cost of the actuators and the invention."

In Appellant's Brief pages 12-13, Part VIII.5, Section 8.5A, Paragraph A6a - Paragraph A7c, the Appellant maintains the Examiner has "an incorrect understanding of the reference[s]". However, the Appellant does not show exactly how the Examiner's "incorrect understanding" affects the rejections of the claims and the Examiner suggests that the Appellant may have an incorrect understanding of the rejection and refers the Appellant to the rejections as reprinted above.

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In Appellant's Brief page 13, Part VIII.5, Section 8.5A, Paragraph A8a - Paragraph A8b, Appellant explains he "has difficulties understanding the rationale" of the rejection of claims 36 and 38-42 under 35 U.S.C. §103(a) as being unpatentable over TONG. However, the rejection and its explanation are clearly stated above.

Appellant further states that "it appears the Examiner also agrees Applicant's such argument of Lack of Success of Others". However, Appellant's statement is misleading. The Examiner's explanation from the previous Office Action (Paper No. 22) is reprinted here for clarification:

24. Applicant states on page 8 section 11.2 and 11.3 of his Response that "There is still no product in the market that is similar to the present invention ... Therefore, there is no evidence for supporting reasonable expectation of success for the proposed modification by the Examiner at the time the present invention was made, which apparently substantiate the conclusions that present invention is nonobvious."

However, while success or lack thereof can be used as evidence of novelty, it is not sufficient in itself to prove novelty. More importantly, Applicant has not pointed out how success or absence in the market place obviates the rejections detailed in paragraphs 3-6 above and Examiner maintains those rejections.

In Appellant's Brief pages 13-14, Part VIII.5, Section 8.5B, Paragraph B1 - Paragraph 1B-I, Appellant states "Embodiments and/or limitations set forth in the following claim languages are not described nor suggested by TONG" and then lists the claim recitations. However, these claim limitations are effectively the same as those addressed above on pages 8-9 of this Examiner's Answer.

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In Appellant's Brief pages 14-16, Part VIII.5, Section 8.5A, Paragraph 1b-ii - Paragraph 1d, Appellant lists more claims that he alleges "patentably distinguish the claimed invention from the combination of TONG and GASPER ET AL." However, the Appellant is not listing specific limitations that he believes are not taught in the combination of TONG and GASPER ET AL but rather listing all the limitations of the claims. These claim limitations are each addressed in the rejections which are reprinted in section (9) above for convenience.

In Appellant's Brief pages 16-22, Part VIII.5, Section 8.5A, Paragraph B2 - Paragraph h.3, Appellant lists his "New and different Functions and Superior Properties of the claimed invention" in these pages. However, as Appellant states on page 17, these are simply "repeated herein as follows" and represent a restating of the aspects of the instant invention as described in the Specification and as repeatedly listed by Appellant in his remarks. These new features have been addressed fully in the rejections as repeated above and further explained in the previous responses to Appellant's arguments.



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In Appellant's Brief page 22, Part VIII.5, Section 8.5A, Paragraph B3 - Paragraph 3e, Appellant argues that TONG is non-analogous art to the instant invention. Examiner disagrees and notes that TONG discloses an interactive, computer-controlled doll, as does the instant invention. Examiner suggests that when Appellant points out paragraph 3c of his Brief that "the problem with which TONG is concerned is to provide a combination of computer and an animated sounding doll and a sound signal-splitter..." the Appellant is pointing out as an inventor and as an expert in the field what the biggest challenge the inventor TONG had to overcome with his invention. However, this is reading too narrowly what TONG discloses and Examiner maintains that TONG, when read as a whole, is analogous to the art of the instant invention for the reasons stated above.

In Appellant's Brief page 23, Part VIII.5, Section 8.5A, Paragraph B4 - Paragraph 4d, Appellant argues that GASPER ET AL is non-analogous art to the instant invention. However, Examiner reminds the Appellant that GASPER ET AL discloses a system for sound-synchronized animation for use in a game, and is therefore analogous art to the instant invention.

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In Appellant's Brief pages 23-25, Part VIII.5, Section 8.5A, Paragraph B5 - Paragraph 8c, Appellant argues that the combinations of prior art made in the rejections of the claims of the instant invention would not be functionally feasible but does not say why they would not be feasible, other than to allege the combination was not suggested in the art.

In Appellant's Brief page 25, Part VIII.5, Section 8.5A, Paragraph B9 - Paragraph 9b, Appellant labels the section "Lack of Success of Others" - a topic already addressed above - but actually argues that solenoids are not used for actuating body parts of dolls. While solenoids are used less now that solid state electronics are more common in toys, at the time the invention was made, solenoids were a common method of moving doll parts up or down, open or close eyes, open or close mouths, etc. The two-state operation of a solenoid made them natural choices for two-option movement: up/down, open/close, etc.

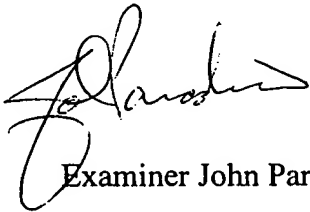
Art Unit: 3721

In Appellant's Brief page 26, Part IX, Appellant "respectfully points out that Applicant received the second Office Action dated 5/15/00 more than six and a half (6.5) months after Applicant's Response filed 10/27/99, and respectfully requests proper advancement of the Application proceeding". However, Appellant is reminded that when he mailed the Response on 10/27/99 (Paper No. 15), he also simultaneously filed a Petition Under 37 CFR 1.181 (Paper No. 16) which required special handling and consideration by the Group Director and also by the Office of Petitions. The Examiner submits that it is disingenuous of the Appellant to suggest that the length of time in the prosecution of this application has been caused by the USPTO. Appellant is also reminded that he has been apprised of this issue before.


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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Examiner John Paradiso



Primary Examiner (Conferee) Jessica Harrison



Supervisory Primary Examiner Peter Vo  
November 21, 2000

Application/Control Number: 08/833,342

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Art Unit: 3721

Shalong Maa, Ph.D., President  
SMA International, Inc.  
816 McDeavitt Drive, #1077  
Arlington, TX 76011

EXHIBIT A

INVALID

Pat. No. 05716423 - 8  
Issue Date: 01/27/03

Group ID: C  
User ID: Sxmahon

Page 1  
KS: 399

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Text Endorsement is required

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Warning [US Reference: Page:1 Posn:3 ]

has an issue date that does not match the patent number

Warning [US Reference: Page:1 Posn:4 ]

has an issue date that does not match the patent number

Warning [Pages Of Foreign References:]

has no references

Warning [Pages Of Other References:]

has no references

CHECK LIST

Rule 47      Continuing Data      PCT      Disclaimer

No      Yes      No      No

Microfiche Appendix      CPA tag

No      Yes

Foreign Priority Claimed: No  
Acknowledged: No

State Code: TX      Country Code:

Text Endorsement: 08833342.040497

*OK*  
*OK*

JACKET

<u>SERIAL NUMBER</u>	<u>FILING DATE</u>	<u>CLASS</u>	<u>SUBCLASS</u>	<u>GAV</u>
08/833,342	04/04/97	446	301	3721

<u>FOREIGN COUNTRY</u>	<u>PRIORITY Document Number</u>	<u>Date</u>
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DISCLAIMER

TITLE

Computer-controlled talking figure toy with animated features

MICROFICHE APPENDIX

ASSISTANT EXAMINER:

<u>First:</u>	<u>Middle:</u>	<u>Last:</u>
John		Paradiso

PRIMARY EXAMINER:

<u>First:</u>	<u>Middle:</u>	<u>Last:</u>
Stephen	F.	Gerrity

CLAIMS ALLOWED

Total      Print

26

DRAWINGS

Sheets      Figures      Print

5

9

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BLUE SLIP INFORMATION

<u>SERIAL NUMBER</u>	<u>CLASS</u>	<u>SUBCLASS</u>	<u>GAU</u>
08/833,342	446	301	3721

INDEP. CLAIMS

1,3,10,17

TOTAL CLAIMS

26

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BLUE SLIP (Page 1)

INTERNATIONAL CLASSIFICATION

Class      SubClass

A63H      3/28

CROSS-REFERENCES

Class      SubClass

369      63

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TERM EXTENSION

924

FIELD OF SEARCH

Class      SubClass

446      298-303

369      63

434      167 307 R, 308, 185



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OATH

INVENTOR NAME

First: Middle: Last: Signed:

Shalong Ma Yes

City: Arlington

State: TX ZIP Code: Country: Foreign ZIP:

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PCT INFO

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CONTINUING DATA (Page 1)

<u>LINE</u>	<u>CODE</u>	<u>SERIAL NUMBER</u>	<u>FILING DATE</u>	<u>STATUS</u>	<u>DOCUMENT NO.</u>	<u>ISSUE DATE</u>
104	68	60/014,905	04/05/1996			/ /

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REFERENCES (Page 1) SERIAL NUMBER: 08/838,342  
FORM 892

U.S. REFERENCES

<u>U.S. Pat No.</u>	<u>Date</u>	<u>Patentee</u>	<u>Class</u>	<u>SubClass</u>
5,636,994	06/1997	Tong	434	308
5,111,409	05/1992	Gasper et al.	345	302
*4,846,693	06/1989 07/1989	Baer	434	308
*3,865,200	12/1972 02/1975	Noll	446	299

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FOREIGN REFERENCES

<u>Foreign Doc No.</u>	<u>Date</u>	<u>Country</u>	<u>Class</u>	<u>SubClass</u>
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OTHER REFERENCE CITATIONS (incl. Author, Title, Date, Pertinent Pages, etc.)

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Pat. No. 05716423 - 8  
Issue Date: 01/27/03

Group ID: C  
User ID: Sxmahon

Page 4

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Maa, Shalong

Application No.: 08/833,342

Art Unit: 3713

Filing Date: April 4, 1997

For: Computer-Controlled Talking Figure Toy with Animated Features

Assistant Commissioner for Patents  
(Box - Patent Appeal)  
Washington, D.C. 20231

The following items are enclosed in this communication:

1. Notice of Appeal
2. BRIEF in Support of Appeal Under 37 C.F.R. § 1.191, 1.192  
(in triplicate, 3 x 33 pages)
3. Copies of *Previously Filed* Evidence - DECLARATION Under 37 C.F.R. § 1.132  
(in triplicate - 3 x 5 pages)
4. Copies of *Previously Filed* Amendment Under 37 C.F.R. § 1.116  
(in triplicate - 3 x 5 pages)
5. Fee for Notice of Appeal - \$150.
6. Fee for Appeal BRIEF - \$150.
7. A Self-addressed Postcard including above Information.

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Certificate of Mailing / Transmission Under 37 C.F.R. § 1.8(a), 1.10

I hereby certify that, on the day shown below, this correspondence is being:

- ☒ Deposited with the United State Postal Service in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 ,
- ☒ as "Express Mail Post Office to Addressee" Mailing No. EK434092510US .


  
SignatureDate: 06/06/00Shalong Maa  
(Type or print name of person certifying)

EXHIBIT C

From: USPTO / Patent App No 08/833,342

We hereby confirm, and inform Mr. Maa, that the following items are received from Mr. Shalong Maa, Ph.D.

- ① Notice of Appeal for Patent App No. 08/833,342
- ② Fee of \$150.<sup>00</sup> for Notice of Appeal
- ③ Brief in Support of Appeal (3 x 33 Pages)
- ④ Fee of \$150.<sup>00</sup> for Brief.
- ⑤ Copies of Declaration and Amendment ( $\frac{3 \times 5 + 3 \times 3}{\text{Pages}}$ )

Serial No. \_\_\_\_\_

Stamp or Signature \_\_\_\_\_



EXHIBIT C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Maa, Shalong

Application No.: 08/833,342

Art Unit: 3713

Filing Date: April 4, 1997

For: Computer-Controlled Talking Figure Toy with Animated Features

Assistant Commissioner for Patents  
Attn: Group Director  
Washington, D.C. 20231

Dear Director:

PETITION TO INVOKE SUPERVISORY AUTHORITY OF THE COMMISSIONER  
UNDER 37 C.F.R. § 1.181

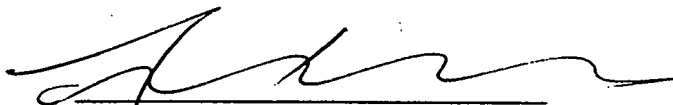
In re ex parte prosecution of the above-identified patent application, Applicant respectfully petitions the commissioner to invoke supervisory authority of the commissioner.

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Certificate of Mailing / Transmission Under 37 C.F.R. 1.8(a), 1.10

I hereby certify that, on the day shown below, this correspondence is being:

- ☒ Deposited with the United Postal Service in an envelope addressed to : Commissioner of Patents and Trademarks, Washington, D.C. 20231,
- ☒ With sufficient postage as Certified First Class Mail with Certification No. Z 205 232 470

  
\_\_\_\_\_  
Signature

Date: 06/13/00

Shalong Maa  
\_\_\_\_\_  
(Type or print name of person certifying)

EXHIBIT D

1. Applicant has previously filed Petition on 10/27/99 under 37 C.F.R. § 1.181, concurrently with Applicant's Response to the Office Action of 08/02/99, to invoke supervisory authority of the Commissioner. The previous Petition was taken from excessive errors and unresponsiveness to Applicant's argument in the Office Action dated 08/02/99, and from communication problems Applicant had during the prosecution. The petition was dismissed by the Group Director for untimely filing and lack of repeated action by the examiner. Applicant respectfully accepted Group Director's decision, as so stated in Applicant's communication submitted 01/10/00.

2. Applicant respectfully points out that, the second Office Action dated 05/15/00 is still unresponsive to Applicant's many important points of argument and citation of authorities, as described in detail hereinbelow, although the Office Action does provide substantial discussion of certain issues raised by Applicant. In addition, Applicant received the Office Action of 05/15/00 more than six and half (6.5) months after Applicant's Response filed 10/27/99. Thus, the present Petition is also taken from the Office's withholding of the application proceeding.

### STATEMENT OF FACTS

#### 3. Withholding of the Proceeding

As described above, the second Office Action dated 05/15/00 was sent to Applicant more than six and half (6.5) months after Applicant's Response filed 10/27/99 without written statement of cause of the delay. Applicant had made several attempts to obtain status information of the application from the Office, including postal-mails and facsimile communication, without any written reply thereto. Applicant also had two telephone conversations with the Examiner during which Applicant was informed that the second Office Action was forthcoming. However, Applicant was not able to receive the second Office Action until after tele-conference with the Group Director, Ms. E. Rollins-Cross, in person on 05/09/00.

#### 4. Unresponsive Office Action / Illogical Argument

4.1. Applicant has vehemently requested that Examiner answer all materials traversed and provide full response to Applicant's each argument point, as so stated in Applicant's previous Response filed 10/27/99 as: "Examiner has[ve] ignored and is unresponsive to almost all points of arguments in the REMARKS [Applicant's previous communication filed 07/04/99] ... Applicant respectfully requests, and insists, that Examiner explicitly addresses (either agree or point out the exact portion that he/she is opposed to), in the ensuing Office Action, each and every point of argument herein and in the REMARKS"

4.2 However, the next Office Action dated 05/15/00 is still unresponsive to Applicant's many important points of argument and citation of authorities, although the Office Action does provide substantial discussion of certain issues raised by Applicant. In some cases, Applicant has difficulties in understanding the rationale of Examiner's argument and response. For example, with respect to Applicant's communication filed 10/27/99:

- (a) (i). The Office Action of 05/15/00 fails to respond to, (1) discussions of "Non-analogous Art" in subsection 4.2 on page 4, (2) citation of authority in subsection 4.1 on page 4 in support of the "Non-analogous Art" argument, and (3) discussions and citation of authority in subsection 4.3 on page 5 in support of the "Non-analogous Art" argument.
- (ii). Note that, the Office Action does provide very brief response to Applicant's request in subsection 4.4 on page 5.
- (b) (i). The Office Action of 05/15/00 fails to respond to, (4) discussions of "Different Structures and Functions" in subsection 5.1 on page 5, in Applicant's Response filed 10/27/99.
- (ii). Note that, in response to Applicant's argument in subsection 5.3 on page 5, the Office Actions of 05/15/00 states in section 18 ( page 12-13), that *"... Applicant's argument fail to comply with 37CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references"*.
- (iii). On the contrary, subsection 5.1 of Applicant's 10/27/99 Response does specifically point out how the claim languages patentably distinguish them from the references, and refers to the REMARKS portion of Applicant's communication of 07/04/99 which also points out how the claim languages patentably distinguishes them from the references (e.g., in section 4, subsections 5.2-3, subsections 5.4-6, and at end of section 7 of the REMARKS). There is no response to these discussions in any of the two Office Actions.
- (c) (i). The Office Action of 05/15/00 fails to respond to, (5) citation and discussion of authority in subsection 6.1 on page 5 in support of the argument under "Claim Limitation Not Being Taught or Suggested in Prior Art", in Applicant's Response filed 10/27/99.
- (ii). Note that, in response to Applicant's argument in subsection 6.3 on page 6, the Office Action states in section 19 on page 13 that *"Applicant's argument fail to comply with 37CFR 1.111(b) because they amount to a general allegation that claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references"*.
- (iii). However, the entire claim languages of Claims 35-36 are drawn to the

IMPROVEMENT of the present invention compared with prior art inventions, and specifically set forth the claim elements that patentably distinguish the claimed invention from the references. Thus, again, Applicant respectfully represents that it is very difficult to understand the rationale of the Examiner's argument.

- (d) (i). The Office Action of 05/15/00 fails to respond to, (6) discussions of "Proposed Modification Not Feasible[ility]" in subsections 7.1-3 on page 6, in Applicant's Response filed 10/27/99.
- (ii). Note that, In response to Applicant's argument in subsection 7.4 on page 6, the Office Action of 05/15/00 states, on page 14 (section 20), that "... *since Applicant has not given any reason why such a modification is not feasible, the argument amounts to a general allegation ....*"
- (iii). On the contrary, Applicant does specifically point out, in the very same section, why the alleged modification of the reference be functionally unfeasible, and refers to Applicant's previous communication of 07/04/99 which also provides technical arguments regarding the alleged modification of the reference being functionally unfeasible. There is no response to these discussions in any of the two Office Actions. Thus, again, Applicant respectfully represents that it is very difficult to understand the rationale and good faith of Examiner's argument.
- (e) The Office Action of 05/15/00 fails to respond to, (7) citation of authority in subsection 9.1 on page 7 in support of the discussion of "Subject Matter as a Whole", in Applicant's Response filed 10/27/99.
- (f) The Office Action of 05/15/00 fails to respond to, (8) discussions of "modification needs to be substantial" in subsection 10.1 on page 7-8, in Applicant's Response filed 10/27/99.

## 5. Interpretation of Statutes Applied

5.1 Applicant acknowledges that majority of the arguments in the Office Actions dated 08/02/99 and 05/15/00 in support of the obviousness Rejections therein are mere statement of Examiner's personal opinion with respect to obviousness of a specific device (i.e., solenoid) employed in the claimed invention, without source of supporting rationale.

5.2 In regarding applying authorities such as MPEP and prior case law in interpretation of the statutes applied in Rejections and lack thereof in the 08/02/99 Office Action, Applicant's Response of 10/27/99 states that "Applicant has provided Legal Precedent in support [of] the arguments herein, and respectfully request that Examiner do the same should he/she is [be] opposed to any of said arguments." and "The value of the exceedingly large body of precedent wherein our predecessor courts and this court have applied the law of obviousness to particular facts, is that there has been built a wide spectrum of illustrations



and accompanying reasoning, that have been melded into a fairly consistent application of law to a great variety of facts.' In re Eli Lilly & Co., 902 F.d. 943, 14 USPQ2d 1741 (Fed. Cir. 1990)" (See also MPEP § 2144 )

5.3 Apparently, the next Office Action of 05/15/00 fails to respond to these requests. As described above, Applicant again does not find any suitable citation or discussion of MPEP, legal precedent or other authorities as basis for interpretation of the statutes applied in the Rejections in response to Applicant's argument, and there is no discussion as to why Applicant's citations of authorities do not provide sufficient support of Applicant's traverses, although all Claims have been rejected.

5.4 (a). The 05/15/00 Office Action does refer to "*In re Fine*" and "*In re Jones*" in section 23 on page 16 in supporting the obviousness rejections therein, which are the only two cases referred to in the Office Actions. Applicant acknowledges that discussions of the court decisions in *In re Fine* and *In re Jones* are also provided in MPEP §2143.01, which states that "In *In re Fine*, ..... The examiner and Board asserted that it would have been within the skill of the art to ..., however the court found there was no support or explanation of this conclusion and reversed. " and "In *In re Jones*, ... The court found there was no suggestion to combine these references to arrive at the claimed invention."

(b). Thus, it appears that the rationale used by the court in both two cases are in support of Applicant's traverses instead of Examiner's ground of Rejections. Thus, again, Applicant has difficulties in understanding the rationale of the argument in the Office Action and Examiner's good faith.

5.5 (a). The 05/15/00 Office Action states, on page 10 (under section 14), that "*where an explanation or argument is being maintained from one Office Action to the next, it is appropriate to 'cut and paste' from the first to the second action in order to avoid unnecessary or confusing changes in wording ...*"

(b). However, Applicant acknowledges that the Office Action of 05/15/00 includes a new statutory basis as ground of rejecting claims, i.e., anticipation Rejections under 35 U.S.C. § 102(e), and the entire arguments in support thereof (section 4 / page 3) is "cut and paste" from Section 4 (page 3-4) of the Office Action dated 11/10/98, which were provided in support of Rejections under a different statutory basis, i.e., obviousness Rejections under 35 U.S.C. § 103(a).

#### POINTS TO BE REVIEWED

6. Applicant respectfully requests that the Group Direct review the foregoing facts and Applicant's, as well as the Examiner's, bona fide attempt to properly advance the application proceeding in good faith.

### ACTIONS REQUIRED

#### 7. Proper Advancement of the Proceeding

7.1 Applicant respectfully represents that proper advancement of the examination proceeding in its regular turn by the Office is vital to Applicant's interests. Applicant has filed Appeal from the Examiner's decision of rejecting Claims to the Board of Patent Appeals and Interference, and is specially concerned with proper advancement of the appeal proceeding.

7.2 Since there has been withholding of the application proceeding by the Office without written statement of cause thereof, as described hereinabove, Applicant hereby respectfully requests proper advancement of the examination and appeal proceedings and that the Group Director supervise the advancement.

#### 8. Answer All Material Traversed

8.1 In Applicant's Response filed 10/27/99, Applicant has vehemently requested that Examiner answer all materials traversed. Applicant believes that such request complies with Office rules, practice, and procedure. However, as described above, the second Office Action dated 05/15/00 still fails to respond to Applicant's many important argument points.

8.2 Applicant has repeated such request of answering all material traversed in the previous Petition and in the recently filed Appeal Brief, and would like to repeat the request herein again as follows:

Each argument section / subsection of the recently submitted Appeal Brief is carefully labeled in numerical and/or alphabetic order for the convenience of the Examiner; Applicant respectfully requests that the ensuing Examiner's Answer or Action provide precise and full response to Applicant's each point of argument therein, i.e., either provide brief statement of agreement therewith, or point out the exact portion that Examiner is opposed to, and state why Applicant's each citation of authority or applying legal precedent does not provide sufficient support of Applicant's traverse if so regarded by the Examiner; Applicant respectfully represents that lack of response to Applicant's any argument point would be construed as Examiner's agreement therewith.

#### 9. Interpretation of Statutes Applied

9.1 In Applicant's Response filed 10/27/99, Applicant has requested that Examiner follow *Graham v. John Deere Co.* in consideration and determination of obviousness of the claimed invention under 35 U.S.C. 103, as required by MPEP § 2141, and that Examiner provides suitable discussion of prior case law or citation of authority in support of the Rejections. Apparently, as described above, these requests have been disregarded by the Examiner.

9.2 Applicant has, in the recently filed Appeal Brief, repeated such request of relying on authorities in obviousness rejections, and would like to repeat the request herein again as follows:

Applicant has provided sufficient citations of authorities and/or discussions of prior case law in recently filed Appeal Brief in support of Applicant's traverses and argument. Applicant respectfully requests that Examiner do the same in the ensuing Examiner's Answer or Action in support of its argument and in interpretation of statutes applied in Rejections, and state therein why Applicant's each citation of authority or reference to prior case law or rationale used by the court does not provide sufficient support of Applicant's traverse if so regarded by the Examiner.

### CONCLUSION

For the foregoing reasons, Applicant respectfully petitions the commissioner to invoke supervisory authority of the commissioner Under 37 C.F.R. § 1.181.

Respectfully submitted,

By: 

Shalong Maa  
(Print name of person signing)

Date: 06/12/00  
SMA International, Inc.  
816 McDeavitt Dr., 1077  
Arlington, TX 76011  
(214) 587-0953

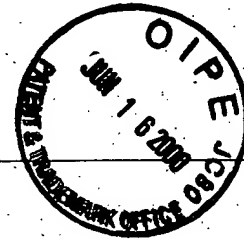
From: USPTO / (App No. 08/833,342)

We hereby confirm, and inform Mr. Maa, that the following items are received from Mr. Shalong Maa, Ph.D.

*Petition To Invoke Supervisory Authority  
of the Commissioner Under 37 CFR 1.181.  
(7 Pages)*

Serial No. \_\_\_\_\_

Stamp or Signature \_\_\_\_\_



PS Form 3800, April 1995

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● is postcard confirms the receiving of the following items by USPTO.

- 1) A Cover page with certification of M
- 2) Acceptance of Decisions on Petitions
- 3) Status Inquiry - Request for Confirmation of "Non-final" status of office Action dated 08/02/99
- 4) Confirmation of "Non-final" status of Office Action dated 08/02/99 - Interview Summary.



EXHIBIT E

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Maa, Shalong

Application No.: 08/833,342

Art Unit: 3713

Filing Date: April 4, 1997

For: Computer-Controlled Talking Figure Toy with Animated Features

Assistant Commissioner for Patents  
Washington, D.C. 20231

Enclosed please find the following items:

I. ACCEPTANCE OF DECISIONS ON PETITIONS

II. STATUS INQUIRY - REQUEST FOR CONFIRMATION OF "NON-FINAL" STATUS OF  
OFFICE ACTION DATED 08/02/99III. CONFIRMATION OF 'NON-FINAL' STATUS OF OFFICE ACTION DATED 08/02/99 -  
INTERVIEW SUMMARY

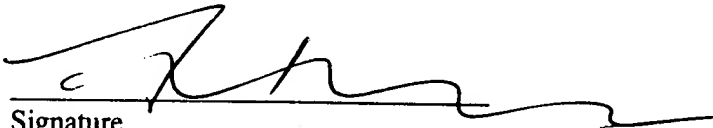
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CERTIFICATION UNDER 37 C.F.R. 1.8(a)

---

I hereby certify that, on the day shown below, this correspondence is being:

- ☒ Deposited with the United Postal Service in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231
- ☒ Mailing with sufficient postage as certified first class mail, with Certification No. Z 205 236 015
- ☐ Mailing as "Express Mail Post Office to Addressee", Mailing No. \_\_\_\_\_
- ☐ Transmitted by facsimile to the Patent and Trademark Office.

  
SignatureDate: Jan 10, 2000Shalong Maa  
(Type or print name of person certifying)

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Maa, Shalong

Application No.: 08/833,342

Art Unit: 3713

Filing Date: April 4, 1997

For: "Computer-Controlled Talking Figure Toy with Animated Features"

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

Applicant submitted, on Jan. 10, 2000, via first class mail, as attached hereto, a correspondence including "Acceptance of Decisions on Petitions", "Status Inquiry - Request for Confirmation of 'Non-final' Status of Office Action Dated 08/02/99", a "Confirmation of 'Non-final' Status of Office Action Dated 08/02/99 - Interview Summary" form to be completed by the Examiner and returned to Applicant, and a postcard. Applicant has received the returned postcard, but there has been no written Confirmation of 'Non-final' Status of Office Action Dated 08/02/99 from the Examiner, as requested by Applicant.

Applicant has not received second Office Action in response to Applicant's "Request for Reconsideration Under 37 C.F.R. §1.111" filed October 27, 1999 either. Thus, in order to avoid unintentional abandonment of the application, Applicant hereby, again, respectfully requests written Confirmation of "Non-final" Status of Office Action Dated 08/02/99. Should it be deemed necessary, Examiner may have said written Confirmation sent to Applicant via both first-class mail and facsimile. Applicant's fax number is (916) 314-8644.

---

CERTIFICATION UNDER 37 C.F.R. 1.8(a)

I hereby certify that, on the day shown below, this correspondence is being:

☒ Transmitted by facsimile to the Patent and Trademark Office, via (703) 305-3579 / 3580  
SignatureDate: Jan 31, 2000Shalong Maa  
(Type or print name of person certifying)

From: USPTO / Patent App No. 08/833,342

We hereby confirm, and inform Mr. Maa, that the following items are received from Mr. Shalong Maa, Ph.D.

- 1) Status Inquiry (1 Page)
- 2) Copies of "Cover Page", "Returned Post Card", and "Mailing Label" for Appeal filed on 06/06/2000
- 3) A cover page with above info and certificate of Mailing

Serial No. \_\_\_\_\_

Stamp or Signature \_\_\_\_\_

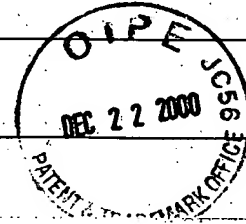


EXHIBIT E2



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Maa, Shalong

Application No.: 08/833,342

Art Unit: 3713

Filing Date: April 4, 1997

For: Computer-Controlled Talking Figure Toy with Animated Features

Assistant Commissioner for Patents  
Washington, D.C. 20231

STATUS INQUIRY

1. More than six (6) months have passed since the filing of a complete Appeal Brief on June 6, 2000, under 37 C.F.R. § 1.191, 1.192, for the above-identified application (see Attachment for the *Cover Page* of the filing and a copy of the *Return Postcard*). Applicant / Appellant has not received Examiner's Answer thereto under 37 C.F.R. § 1.193.
2. During two Telephone Interviews with the Examiner and the Group Director, respectively, on 11/13/2000, Applicant / Appellant was informed that the Examiner's Answer was to be sent to the Applicant / Appellant by that weekend (11/17/2000), as indicated in Applicant / Appellant's "Telephone Interview Summary" submitted thereafter via facsimile. However, Applicant / Appellant still has not yet received the Examiner's Answer. During the telephone interviews, Applicant / Appellant also called the Examiner and the Group Director's attention to the effect that the "Notification of Non-Compliance with 37 CFR 1.192(c)" dated 07/26/2000 (Paper No. 28) does not comply with MPEP § 1206.
3. Please kindly advise the undersigned Applicant / Appellant of the present status of this application and the Appeal proceeding.

Respectfully submitted,

By: 

Shalong Maa

(Print name of person signing)

Date: 12/17/2000  
816 McDeavitt Dr., 1077  
Arlington, TX 76011  
(817) 795-3526

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Maa, Shalong

Application No.: 08/833,342

Art Unit: 3713

Filing Date: April 4, 1997

For: Computer-Controlled Talking Figure Toy with Animated Features

Assistant Commissioner for Patents  
Attn: Group Director  
Washington, D.C. 20231

TELEPHONE INTERVIEW SUMMARY

The telephone interview between the undersigned Applicant and the Group Director, Ms. E. Rollins-Cross on 11/13/2000 is summarized herein as follows:

- (1) Applicant pointed out that the Examiners assigned to the present case have not been following the Examination procedures described in MPEP. For example, the "Notification of Non-Compliance with 37 CFR 1.192(c)" dated 07/26/2000 (Paper No. 28) does not comply with MPEP§ 1206 which states that, "*The brief of a pro se appellant which does not contain all of the items, (1) to (9), specified in 37 CFR 1.192c will be accepted as long as it substantially complies with the requirements of items (1), (2), and (8)*" [Note: description of other problems in the previous Office Actions are provided in Applicant's Petitions filed 10/27/1999 and 06/13/2000]

---

**Certificate of Mailing / Transmission Under 37 C.F.R. 1.8(a)**

I hereby certify that, on the day shown below, this correspondence is being:

☒ Transmitted by facsimile [ (703) 305-3579 ] to the Patent and Trademark Office.


  
SignatureDate: 11/14/2000Shalong Maa  
(Type or print name of person certifying)

EXHIBIT E3

- (2) Applicant also pointed out that the prosecution of the present application have been delayed by the Examiners repeatedly and for substantial amount of time [the Examiners did not respond to Applicant's communication filed 10/27/99 for more than six months until 05/15/2000; and the Examiner has not yet acted on (the answer to) Applicant's Appeal Brief, which was filed more than five months ago on 06/06/2000];
- (3) Applicant mentioned the importance and projected market value of the invention and potential damage to Applicant's business interests caused by the delay;
- (4) The Group Director agreed that the Examiner(s) will complete the answer to Applicant's Appeal Brief by the end of this week (11/17/2000);
- (5) Applicant acknowledged, during the interview, that the Primary/Supervisory Examiner of the present case has been changed to Mr. VO PETER DUNG. According to Applicant's understanding, the Group Director cited the Assistant Examiner Mr. John Paradiso's changing group unit as cause thereof.

Respectfully submitted,

By: 

Sherry Mae  
(Print name of person signing)

Date: 11/14/2000  
SMA International, Inc.  
816 McDeavitt Dr., 1077  
Arlington, TX 76011  
(817) 795-3526

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Maa, Shalong

Application No.: 08/833,342

Art Unit: 3713

Filing Date: April 4, 1997

For: Computer-Controlled Talking Figure Toy with Animated Features

Assistant Commissioner for Patents  
Washington, D.C. 20231

## TELEPHONE INTERVIEW SUMMARY

The telephone interview between the undersigned Applicant and the (Assistant) Examiner Mr. John Paradiso on 11/13/2000 is summarized herein as follows:

- (1) Applicant pointed out that Examiners' "Notification of Non-Compliance with 37 CFR 1.192(c)" dated 07/26/2000 (Paper No. 28) does not comply with MPEP§ 1206 [which states that, "*The brief of a pro se appellant which does not contain all of the items, (1) to (9), specified in 37 CFR 1.192c will be accepted as long as it substantially complies with the requirements of items (1), (2), and (8)*"];]
- (2) Applicant also pointed out that the prosecution of the application has been delayed by the Examiners repeatedly and for substantial amount of time [the Examiners did not respond to Applicant's communication filed 10/27/99 for more than six months until 05/15/2000; and the Examiners have not yet acted on (the answer to) Applicant's Appeal Brief, which was filed more than five months ago on 06/06/2000];

---

Certificate of Mailing / Transmission Under 37 C.F.R. 1.8(a)

I hereby certify that, on the day shown below, this correspondence is being:

☒ Transmitted by facsimile [ (703) 305-3579 ] to the Patent and Trademark Office.

  
Signature

Shalong Maa

Date: 11/14/2000

(Type or print name of person certifying)

EXHIBIT E4

- (3) The Examiner agreed to complete the answer to Applicant's Appeal Brief by Thursday of this week (11/16/2000);
- (4) Applicant mentioned to the Examiner the importance and projected market value of the invention and potential damage to Applicant's business interests caused by the delay.

Respectfully submitted,

By: 

Sharon Mae

(Print name of person signing)

Date: 11/14/2000  
SMA International, Inc.  
816 McDeavitt Dr., 1077  
Arlington, TX 76011  
(817) 795-3526

From: USPTO/AppNo. 08/833,342

We hereby confirm, and inform Mr. Maa, that the following items are received from Mr. Shalong Maa, Ph.D.

- 1) Fee of \$150.<sup>00</sup>
- 2) Request for Certified Copies of File wrapper and contents Under 37CFR1.59(c) (1 Pages)

Serial No. \_\_\_\_\_

Stamp or Signature \_\_\_\_\_



<b>SHALONG MA</b> 03-00 816 MCDEAVITT DR. APT. 1077 ARLINGTON, TX 76011-6027		CHECK HERE IF TAX DEDUCTIBLE ITEM <input type="checkbox"/>	
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12/17/2000			
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One hundred and fifty dollars <sup>00</sup> / <sub>100</sub>		PAYMENT	
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AppNo 08/833/342 / Certified copy For added serial 08/833,342: File wrapper account number no longer appears on this copy.		0531 NOT NEGOTIABLE	

EXHIBIT FI

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Maa, Shalong

Application No.: 08/833,342

Art Unit: 3713

Filing Date: April 4, 1997

For: Computer-Controlled Talking Figure Toy with Animated Features

Assistant Commissioner for Patents  
(Box - Document Supply & Fee)  
Washington, D.C. 20231

Dear Sir:

REQUEST FOR CERTIFIED COPIES OF FILE WRAPPER AND ALL CONTENTS  
UNDER 37 C.F.R. § 1.59(c), 1.19(b)(2)

1. Applicant hereby respectfully requests, under 37 C.F.R. § 1.59(c), that certified copies of the File Wrapper and all Contents therein for the above-identified application be furnished to the undersigned Applicant.
2. The required Document Supply Fee of \$150.00, under 37 C.F.R. § 1.19(b)(2), is enclosed.

Respectfully submitted,

By: 

Shalong Maa

(Print name of person signing)

Date: 12/17/2000

SMA International, Inc.  
816 McDeavitt Dr., 1077  
Arlington, TX 76011  
(817) 795-3526



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

Date

1/19/01

Dear \_\_\_\_\_

This is in response to your correspondence dated 1/16/01.

Your order for certified copies of File Wrapper 08833342 can not be filled for the following reason(s):

I | Our records indicate that you are not entitled to obtain a copy of this pending application. Copies of pending applications may only be obtained with written consent of the applicant, attorney of record, or assignee.

I | This office cannot identify the copy you requested. The information/number given is either incomplete or does not correspond with existing PTO records:

\_\_\_\_ inventor name \_\_\_\_ filing/issue date \_\_\_\_ title \_\_\_\_ mark

IV | Insufficient payment was received. The total amount to process your order is \$ 225. Please furnish the PTO with \$ 75 to complete the processing of your order. We will accept Visa, Mastercard, Check or Money Order. Make check or money order payable to Commissioner of Patent and Trademarks.

I | Copies of U.S. Patent Number \_\_\_\_\_ cannot be furnished. It has been withdrawn from issue. If there are other patents within your order, they are being processed and will be forwarded to you under separate cover.

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I | Other: \_\_\_\_\_

If you have any question or need additional information, please contact our Customer Service Department at (703) 308-9726.

Sincerely,



Customer Service  
Office of Public Records

EXHIBIT F2



## UNITED STATES PATENT AND TRADEMARK OFFICE

Maa, Shalong

08/833,342

3713

April 4, 1997

Computer-Controlled Talking Figure Toy with Animated Features

COPIES OF FILE WRAPPER AND ALL CONTENTS  
 UNDER 37 C.F.R. § 1.59(c), 1.19(b)(2)

requests, under 37 C.F.R. § 1.59(c), that certified copies of  
 for the above-identified application be furnished to the

Required Document Supply Fee of \$150.00, under 37 C.F.R. § 1.19(b)(2), is enclosed.

Respectfully submitted,

By

shalong Maa

SHALONG MAA

(Print name of person signing)

Date: 01/09/2001

SMA International, Inc.  
 816 McDeavitt Dr., 1077  
 Arlington, TX 76011  
 (817) 795-3526

SHALONG MAA 03-00  
 816 MCDEAVITT DR. APT. 1077  
 ARLINGTON, TX 76011-6027

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Bank of America.

For App # 08/833,342 / certified  
 file wrapper

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Maa, Shalong

Application No.: 08/833,342

Art Unit: 3713

Filing Date: April 4, 1997

For: Computer-Controlled Talking Figure Toy with Animated Features

Attn: Ms. Brown, Q. C. Specialist  
Box - Office of Public Record  
Assistant Commissioner for Patents  
Washington, D.C. 20231

TELEPHONE INTERVIEW SUMMARY

1. This correspondence is to confirm the tele-conference on 02/16/2001 between the undersigned Applicant and Ms. Brown, Q. C. Specialist of the Office of Public Records, with respect to Applicant's ordering of Certified Copies of File Wrapper and Paper Contents of the above-identified patent application. Applicant confirms his authorization to charge Applicant's credit card account for the amount of \$150.00 in addition to the credit card payment of \$75.00 submitted on 02/09/2001. Thus, a total payment of \$225.00, pursuant to 37 C.F.R. §1.19(b)(2)(i)-(iii), as amended, including document supply fee (File Wrapper and Paper Contents) and certification fee, has been submitted.
2. Applicant's correspondence, submitted on 12/17/2000 via First Class Postal Mail, for requesting Certified Copies of File Wrapper and Paper Contents, including payment \$150.00 enclosed therein, is deemed missing after reaching the Office. Thus, this is no response thereto from the Office.

Respectfully submitted,

By: 

SHALONG MA

(Print name of person signing)

Date: 02/19/2001  
SMA International, Inc.  
816 McDeavitt Dr., 1077  
Arlington, TX 76011  
(817) 795-3526

P.S. This correspondence is to be submitted via both facsimile (703-308-7048) and First Class Postal Mail.

EXHIBIT F3

From: USPTO / Patent App No. 08/833,342

We hereby confirm, and inform Mr. Maa, that the following items are  
received from Mr. Shalong Maa, Ph.D.

- 1) Telephone Interview Summary  
(1 Page)
- 2) Transmittal Form (1 Page)

FEB 23 2001

Serial No. \_\_\_\_\_

Stamp or Signature \_\_\_\_\_

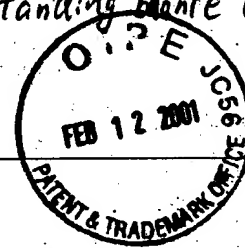
From: USPTO / Patent App. No. 08/833.342

We hereby confirm, and inform Mr. Maa, that the following items are received from Mr. Shalong Maa, Ph.D.

- 1) Credit Card Payment Form for payment of \$75.<sup>00</sup>
- 2) Copy of Communication from Office of Public Records dated 1/19/01 (1 Page)
- 3) A statement of Payment of outstanding Honor (1 Page)

Serial No. \_\_\_\_\_

Stamp or Signature \_\_\_\_\_



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Maa, Shalong

Application No.: 08/833,342

Art Unit: 3713

Filing Date: April 4, 1997

For: Computer-Controlled Talking Figure Toy with Animated Features

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

PAYMENT OF OUTSTANDING BALANCE FOR CERTIFIED COPIES OF FILE WRAPPER  
AND PAPER CONTENTS UNDER 37 C.F.R. §1.19(b)(2)

1. The undersigned Applicant has previously filed request for certified copies of paper portion of File Wrapper and Contents for the above-identified patent application, with payment of Document Supply Fee of \$150.00 enclosed therein. However, Applicant was not aware of the latest Revision of PTO Fees. The communication from the Office, dated 01/19/2001, as attached hereto, indicates that there is an outstanding balance of \$75.
2. Accordingly, a credit card payment of \$75.00 is enclosed herein. Thus, a total payment of \$225.00, pursuant to 37 C.F.R. §1.19(b)(2)(i)-(iii) as amended, including document supply fee (File Wrapper and Paper Contents) and certification fee, has been submitted.

Respectfully submitted,

By: 

SHALONG MAA

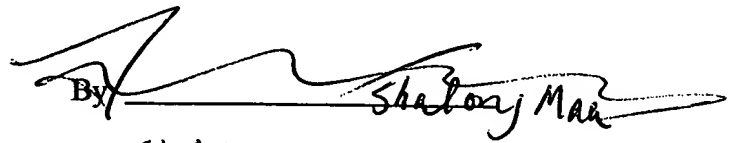
(Print name of person signing)

Date: 02/09/2001

SMA International, Inc.  
816 McDeavitt Dr., 1077  
Arlington, TX 76011  
(817) 795-3526

4. It is Applicant's understanding that the Office should maintain all written communication (other than partial payment of fees required) from the Applicant for a pending patent application, especially those legally submitted under a specific provision of Patent Rules or Title 37, instead of returning the original paper submitted back to the Applicant without written request therefore. Thus, copies of all paper items submitted on 01/10/2001 (EXHIBIT B) are hereby resubmitted for the purpose of Office recordation for the above-identified application, and such action is respectfully requested.

Respectfully submitted,

By  Shalong Maa

SHALONG MA  
(Print name of person signing)

Date: 02/19/2001  
SMA International, Inc.  
816 McDeavitt Dr., 1077  
Arlington, TX 76011  
(817) 795-3526

P.S. This correspondence is to be submitted via both facsimile and First Class Postal Mail.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Maa, Shalong

Application No.: 08/833,342

Art Unit: 3721 / 3713

Filing Date: April 4, 1997

For: Computer-Controlled Talking Figure Toy with Animated Features

Box - Office of Public Record  
Attn: B. Fenwick, Supervisor  
Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

I. PAPER MISSING

1. The undersigned Applicant submitted, on 12/17/2000, via First Class Postal Mail, a correspondence (EXHIBIT A) for requesting Certified Copies of File Wrapper and Paper Contents, under 37 C.F.R. §1.59(c), 1.19(b)(2), for the above-identified patent application, with a payment of \$150.<sup>00</sup> enclosed therein. Said correspondence is deemed missing according to Applicant's tele-conference with the Q. C. Specialist on 02/16/2001 (EXHIBIT D).

2. However, it appears that said correspondence has been recorded in the Office, since the self-addressed postcard enclosed therein has been returned to the Applicant (EXHIBIT A). Thus, Applicant respectfully requests that the Supervisor review the Office record and have said payment returned to Applicant should it be recovered. [Note: Applicant has authorized the Q. C. Specialist to charge all required fees to Applicant's credit card account submitted (EXHIBIT D) ]

II. PAPER RECORDATION

3. Applicant's second Request for Certified Copies of File Wrapper and Paper Contents, under 37 C.F.R. §1.59(c), 1.19(b)(2), was submitted on 01/10/2001 via First Class Postal Mail (EXHIBIT B-C). However, the entire original correspondence, including the envelop, the signed original statement for requesting certified copies, and a (second) payment of \$150.<sup>00</sup>, are returned to the Applicant (EXHIBIT B).

From: USPTO / Patent App No. 08/833,342

We hereby confirm, and inform Mr. Maa, that the following items are received from Mr. Shalong Maa, Ph.D.

- 1) A Transmittal form (PTO/SB/21)
- 2) A cover page with listing of Items enclosed
- 3) Statement of "PAPER MISSING" and "PAPER RECORDATION" (1 Pages)
- 4) Exhibit A, B, C, D ( $3 + 3 + 1 + 1 = 8$  Pages)

Serial No. \_\_\_\_\_

Stamp or Signature \_\_\_\_\_

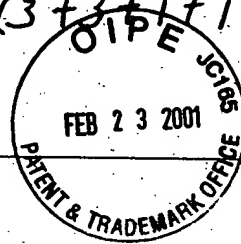


EXHIBIT F5





**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of : Maa, Shalong

Application No. : 08/833,342

Art Unit : 3713

Filing Date : April 4, 1997

For : Computer-Controlled Talking Figure Toy with Animated Features

Total No of Pages : 7 (Including this page)

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**TO:**

Mr. Stephen G. Kunin  
Deputy Commissioner  
Washington, D.C. 20231

The following items are enclosed in this communication:

**PETITION TO THE DEPUTY COMMISSIONER - SPECIAL CIRCUMSTANCES**

EXHIBIT F6

# BILLING STATEMENT



Account Number 4417 2942

H4P7 010308  
RYD 103 7 5  
5630 0217 3366 7000 OIAF5630 42

Statement Date	New Balance	Payment Due Date	Past Due Amount	Minimum Payment
03/08/01	\$4,787.85	04/02/01	\$0.00	\$95.00

Amount Enclosed \$

Please make checks payable to First USA Bank, N. A. and allow 7-10 days for payment to be received. First USA is the issuer of this account. Send top portion of statement with payment in enclosed envelope.

Page 1 of 1

FIRST USA BANK, NA  
P.O. BOX 50882  
HENDERSON NV 89016-0882

SHALONG MAA  
816 MCDEAVITT DR  
NO 1077  
ARLINGTON TX 76011-6035



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New Address or E-mail?  
Please see reverse side of form.



CUSTOMER SERVICE  
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PO Box 8650  
Wilmington, DE 19899-8650

ADDITIONAL PAYMENTS  
P.O. BOX 50882  
HENDERSON NV 89016-0882

Statement Date 03/08/01  
Account Number 4417 1273 2604 2942

## ACCOUNT SUMMARY

Previous Balance	\$3,836.36	Payment Due Date	04/02/01
+ Purchases, Fees and Adjustments	\$955.91	Minimum Payment Due	\$95.00
+ Cash Advances	\$0.00	Total Credit Line	\$14,200
+ Finance Charges	\$71.58	Cash Advance Credit Line†	\$2,840
- Payments and Credits	\$76.00	Available Credit	\$9,412
= New Balance	\$4,787.85	Available Portion for Cash Advances	\$90

† Cash Advance Credit Line is a portion of your total Credit Line.

## YOUR REWARDS

Points Available from Previous Statement	5841
+ Points for Philips Purchases	0
+ Points for Other Purchases	956
+/- Bonus/Adjustments	0
= Total Points Earned this Statement	956
- Points Redeemed this Statement	0
= Total Points Available	6797

TRANS DATE	POST DATE	REFERENCE NUMBER	MERCHANT NAME OR TRANSACTION DESCRIPTION	AMOUNT
0211	0211	24246511BFSLF01L1	KINKO'S ARLINGTON ARLINGTON TX	0.45
0211	0211	24661621BQ1JT9X9P	ALBERTSON'S #4271 S9H ARLINGTON TX	34.12
0212	0212	24301281E09PPJ0VX	US PATENT/TRADEMARK OF WASHINGTON DC	620.00
0212	0212	24403691DS696HD1J	ASIAN GRILL ARLINGTON ARLINGTON TX	13.03
0219	0219	24661621KQ1JS28N6	MAX FOODS #1707 S9H ARLINGTON TX	9.08
0220	0220	24301281M09TSA4FY	US PATENT/TRADEMARK OF WASHINGTON DC	225.00
0224	0224	24403691RS697JZ2Z	ASIAN GRILL ARLINGTON ARLINGTON TX	8.00
0224	0224	24492801R3DZM1218	HALF PRICE BOOKS #60 ARLINGTON TX	10.69
0226	0226	24661621SQ1JSPK7D	ALBERTSON'S #4271 S9H ARLINGTON TX	30.56
0228	0228	74417121V28NX06GZ	PAYMENT - THANK YOU	76.00-
0303	0303	24661621ZQ1K22GGX	MAX FOODS #1707 S9H ARLINGTON TX	4.98
0308	0308		*FINANCE CHARGE*	71.58

Here's how we determine your finance charge:

PERIODIC RATE(S) AND APR(S) MAY VARY

FINANCE CHARGE SUMMARY	AVERAGE DAILY BALANCE	MONTHLY PERIODIC RATE	CORRESPONDING ANNUAL PERCENTAGE RATE	PERIODIC FINANCE CHARGE
Purchases	\$1,766.29	1.429 %	17.15%	\$25.24
Cash Advances	\$2,781.71	1.666 %	19.99%	\$46.34
EFFECTIVE ANNUAL PERCENTAGE RATE	18.88%	TOTAL PERIODIC FINANCE CHARGE		\$71.58

Please see reverse side for balance computation method and other important information.

EXHIBIT F7



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Maa, Shalong

Appeal No.: 2001-0908

Application No. : 08/833,342

Art Unit : 3721/ 3713

Filing Date : April 4, 1997

For : "Computer-Controlled Talking Figure Toy with Animated Features"

Total No of Pages : 6 (Including this page)

Via Fax : (703) 308-7010

---

**TO:**

OFFICE OF PUBLIC RECORDS  
Attn: Ms. Murray, Gloria  
Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Ms. Murray :

First I would like to apologize to you for not being able to reply to your voice messages. I've been having some urgent personal problems, which causes the changing of my correspondence address, as indicated hereinbelow.

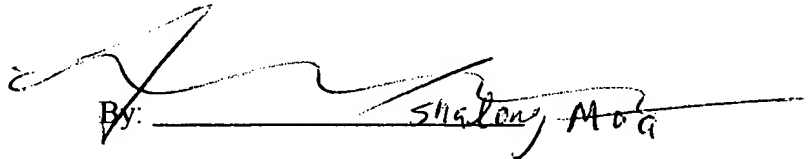
In regarding my Request for "Certified Copies of File Wrapper and Paper Contents", and in accordance with the telephone messages from the Office, I acknowledge the deficiency of the fees

EXHIBIT F8

therefor submitted earlier (A document supply fee of \$225 previously submitted has been accepted by the Office, see EXHIBIT-B attached hereto), resulting from my lacking in the knowledge of the volume of the documents requested prior to said telephone messages. Accordingly, the "REQUEST FOR CERTIFIED COPIES OF SELECTED PAPERS IN THE APPLICATION FILE (Amendment of the Previous Request for File Wrapper and All Contents)" attached hereto has been made solely to comply with the fee requirement.

Thank you very much for the consideration.

Respectfully submitted,

By:   
MAA, SHALONG  
(Print name of person signing)

Date: 04/26/2001

P.O. Box 202930  
Arlington, TX 76006

P.S. : Please be aware that Applicant's Correspondence Address has been changed, as indicated hereinabove (the "CHANGE OF CORRESPONDENCE ADDRESS" form, as attached hereto as EXHIBIT-A, has been submitted to the Board of Patent Appeals and Interferences)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Maa, Shalong

Appeal No.: 2001-0908

Application No. : 08/833,342

Art Unit : 3721 / 3713

Filing Date : April 4, 1997

For : "Computer-Controlled Talking Figure Toy with Animated Features"

OFFICE OF PUBLIC RECORDS  
Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

REQUEST FOR CERTIFIED COPIES OF SELECTED PAPERS IN THE APPLICATION FILE  
(Amendment of the Previous Request for Copies File Wrapper and All Contents)

1. The undersigned Applicant of the above-identified patent application has previously requested for "Certified Copies of File Wrapper and All Paper Contents", and has submitted document supply fees therefor for a total of \$375 (\$150+\$225). The first submission of \$150, made on 12/17/2000, was deemed missing by the Office; The second submission of \$150 made on 01/09/2001 was returned to Applicant; The third submission of \$225 has been charged to Applicant's credit card account by the Office (EXHIBIT-B). Applicant has not yet received the required documents.
2. Applicant acknowledges, in accordance with recent telephone messages from the Office, the deficiency of said fees submitted, resulting from Applicant's lacking in knowledge of the volume of the documents requested prior to said telephone messages. Accordingly, Applicant would like to amend such request as follows:
3. In stead of copies of the "File Wrapper and All Paper Contents", please furnish the following certified papers in the application file to Applicant's new correspondence address :  
  
(3.1) : Certified copies of the "EXAMINER'S ANSWER", dated 12/28/2000 (mailing date) ;

- (3.2) : Certified copies of Applicant's "APPEAL BRIEF", submitted on 06/06/2000 ;
- (3.3) : Certified copies of Applicant's "APPEAL BRIEF", filed 08/29/2000 ;
- (3.4) : Certified copies of Applicant's "DECLARATIONS TRAVERSING GROUNDS OF REJECTION UNDER 37 C.F.R. § 1.132", submitted on 06/05/2000 via facsimile ;
- (3.5) : Certified copies of the Examiners' "OFFICE ACTION" dated 05/15/2000;
- (3.6) : Certified copies of Applicant's "PRELIMINARY AMENDMENT", Including A "SUBSTITUTE SPECIFICATION" and "REMARKS", submitted on 07/04/1999, and were entered on 07/02/1999 as Paper No.13 ;
- (3.7) : Certified copies of Applicant's "NON-PROVISIONAL PATENT APPLICATION" filed on 04/04/1997 ;
- (3.8) : Certified copies of Applicant's "PROVISIONAL PATENT APPLICATION" filed on 04/05/1996.

4. Thus, according to 37 C.F.R. § 1.19(b)(4), a total document supply fee of \$200 (8 x \$25) is required for the foregoing requests. As described above, a document supply fee of \$225 has already been charged to Applicant's credit card account by the Office (EXHIBIT-B). Please refund the remaining balance by credit to said credit card account to which the fee was charged. Should any more fee be due in connection with this paper, please inform Applicant at the Office's earliest convenience.

Respectfully submitted,

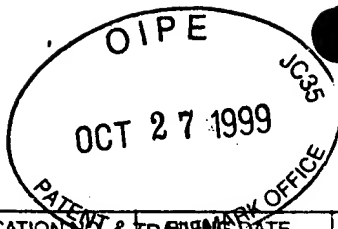
By: 

MAA. SHALONG

(Print name of person signing)

Date: 04/26/2001  
P.O. Box 202930  
Arlington, TX 76006

P.S. : Please be aware that Applicant's Correspondence Address has been changed, as indicated above (the "CHANGE OF CORRESPONDENCE ADDRESS" form, as attached hereto as EXHIBIT-A, has been submitted to the Board of Patent Appeals and Interferences)



**CLIENT'S COPY**  
UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO. & FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/833,342 04/04/97 MAA

8 0807.208

EXAMINER
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08121/1110

MARC A. HUBBARD  
MUNSCH HARDT KOFF HARR & DINAN  
1445 ROSS AVE./SUITE 4000  
DALLAS TX 75202

PARADISE, I

ART UNIT	PAPER NUMBER
----------	--------------

3713

DATE MAILED:

11/10/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**EXHIBIT B**

**RECEIVED**

NOV 12 1998

MHKH & D

DOCKETED: \_\_\_\_\_  
DATE: 11/12/98  
BY: [Signature]

# Office Action Summary

Application No.  
08/833,342

Applicant(s)

MAA

Examiner

John Paradiso

Group Art Unit

3721

☒ Responsive to communication(s) filed on Sep 2, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-28 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-28 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---



Art Unit: 3721

## DETAILED ACTION

### Response to Amendment

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The cancellation of claims 29-35, drawn to a data storage media instructions method, is acknowledged.

3. Claims 3-8, 10, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 3 line 4, the "text data" has no antecedent basis.

In claim 4 line 1, the "dictionary" has no antecedent basis.

In claim 5 line 4, the "dictionary" has no antecedent basis.

Art Unit: 3721

In claim 6 line 2, the "dictionary" has no antecedent basis.

In claim 7 line 2, the "dictionary" has no antecedent basis.

In claim 8 line 3, the "text data" has no antecedent basis.

In claim 10 line 4, the "text data" has no antecedent basis.

In claim 21 line 4, the "text data" has no antecedent basis.

*Claim Rejections - 35 USC § 103*

4. Claims 1, 2, 9, 12-14, 20-25, and 28 are rejected under 35 U.S.C. §103(a) as being unpatentable over TONG.

TONG discloses an interactive, computer-controlled doll, as described in the previous Office Action. TONG discloses providing a signal from the computer to the doll, which in turn moves the appropriate parts of the doll (mouth, arms, etc.) depending on whether the signal is present or not. Note that while the information within the signal is analog data, the dolls actuators respond to the presence or lack of the signal, taking not the audio data within, but the presence of the signal itself as a logic signal.

Art Unit: 3721

TONG also discloses (in embodiment in Fig. 6) a voice-recognition feature where the user can speak into a microphone and the computer will recognize the words and provide the appropriate signal(s) to the doll.

(See TONG columns 2-4 and figures 1 and 6.)

TONG does not specifically disclose "storing an array of data representing said logic-control signals ... correlated to said spoke words" or the dimensions of such an array.

However, Applicant is given Official Notice that the use of arrays to store and coordinate data is a basic programming technique and it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an array of memory variables to store inputted data, the results of the inputted data, and programmed responses to that data.

Art Unit: 3721

5. Claims 3-8, 10, 15-19, 26, and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over TONG, as applied to claims 1, 9, 14, and 25 above, and further in view of GASPER ET AL.

TONG substantially discloses the claimed invention except for the specifically describing the generation of a text file or sound dictionary file in response to inputted voice data.

GASPER ET AL discloses a system for sound-synchronized animation for use in a game, as described in the previous Office Action. GASPER ET AL builds and saves its own dictionary file after determining the proper lip synchronization of an inputted word. GASPER ET AL also teaches different articulations for various sounds: silence, vowels, and consonants.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the method of sound analysis used in GASPER ET AL in the invention of TONG in order to efficiently and accurately analyze and coordinate the inputted user sounds with the movement signals sent to the doll of TONG.

Examiner also notes that TONG does disclose the use of voice-recognition software to analyze inputted voice data. Examiner also notes that it is a standard programming technique to store inputted data of all types, including voice recognition data, in

Art Unit: 3721

memory arrays for temporary use and in text files for permanent storage and later retrieval.

Regarding claims 15, 16, 26, and 27, Applicant is given Official Notice that the use of solenoids as actuators for the movement of dolls and figures is well known in the art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to connect two-phase solenoids as the actuators in the invention of TONG in order to reduce the complexity and cost of the actuators and the invention.

Response to Arguments

6. Applicant's arguments filed September 2, 1998 have been fully considered but they are not persuasive.

7. Applicant states on page 9 of his Response that "Tong fails to disclose the use of a computer to generate a logic-control signal to actuate a toy figure, as recited in claim 1. Tong only employs an analog signal...".

However, as explained above, TONG discloses providing a signal from the computer to the doll, which in turn moves the appropriate parts of the doll (mouth,

Art Unit: 3721

arms, etc.) depending on whether the signal is present or not and while the information within the signal is analog data, the dolls actuators respond to the presence or lack of the signal, taking not the audio data within, but the presence of the signal itself as a logic signal.

8. Applicant states on page 9 of his Response that "Tong fails to disclose a memory for storing data representing the logic-control signals and correlated to the spoken words."

However, as explained above, GASPER ET AL discloses building and saving its own dictionary file after determining the proper lip synchronization of an inputted word and also teaches different articulations for various sounds: silence, vowels, and consonants and it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the method of sound analysis used in GASPER ET AL in the invention of TONG in order to efficiently and accurately analyze and coordinate the inputted user sounds with the movement signals sent to the doll of TONG. Examiner also noted that TONG does disclose the use of voice-recognition software to analyze inputted voice data and it is also a standard programming technique to store inputted data of all types, including voice recognition data, in

Art Unit: 3721

memory arrays for temporary use and in text files for permanent storage and later retrieval.

9. Applicant states on page 11 of his Response that "Nevertheless, applicant traverses any suggestion that increasing the array dimension would be obvious."

However, as noted above, it is a standard programming technique to store inputted data of all types, including voice recognition data, in memory arrays for temporary use and in text files for permanent storage and later retrieval and to dimension the array to fit the number of related variables.

10. Applicant states on page 12 of his Response that "neither reference [TONG or GASPER ET AL] provides any suggestion or motivation to combine the references. The Examiner has recognized that 'Gasper does not teach employing this system in a physical doll.' (Office Action; Section 12). Nevertheless, the Examiner states that it would have been obvious to use Gasper's teachings to 'capture a child's attention longer.' As this is one of Applicant's stated objectives, and as the Examiner has failed to provide a citation to prior art in support of this stated motivation, it is respectfully

Art Unit: 3721

submitted that the Examiner's combination of Tong and Gasper to support the rejection appears to be based on impermissible hindsight."

However, as explained in the rejection above, TONG substantially discloses the claimed invention except for the specifically describing the generation of a text file or sound dictionary file in response to inputted voice data. GASPER ET AL discloses a system for sound-synchronized animation for use in a game, including building and saving its own dictionary file after determining the proper lip synchronization of an inputted word and it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the method of sound analysis used in GASPER ET AL in the invention of TONG in order to efficiently and accurately analyze and coordinate the inputted user sounds with the movement signals sent to the doll of TONG.

11. Applicant states on page 13 of his Response that "Tong does not disclose an 'actuator ...having only two phases."

However, as explained in the rejection above, Applicant has been given Official Notice that the use of solenoids (which are inherently two-phase actuators) as actuators for the movement of dolls and figures is well known in the art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to connect



Art Unit: 3721

two-phase solenoids as the actuators in the invention of TONG in order to reduce the complexity and cost of the actuators and the invention.

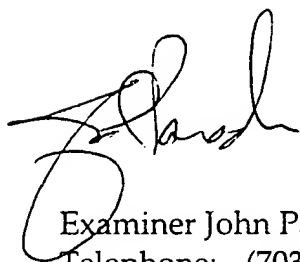
**Conclusion**

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3721

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to:



Examiner John Paradiso  
Telephone: (703) 308-2825  
Fax: (703) 305-3579/3580



Jessica J. Harrison  
Supervisory Patent Examiner  
Group 1700

November 6, 1998

From: John.Paradiso@USPTO.GOV | Block address  
To: smaa@rotfl.com  
Subject: Correspondence  
Date: Wed, 30 Jun 1999 11:56:28 -0400  
Add Addresses

Hi, Mr. Maa. I thought this might be a more convenient and cost-effective way for us to communicate administrative things like interview timing, simple status requests, etc. Of course, we can not use email to discuss specifics about your case or claims since the Internet is not secure but for simple scheduling, it will be fine.

The fees for your CPA, extension of time, and claims all have authorization to deduct them from the account of your former attorney. Since those authorizations were given prior to the change in power of attorney, they are still being deducted from that account.

I'd like to give you my fax numbers again:

(703) 305-3579 (for FORMAL papers to be entered into the case file)  
(703) 308-2825 (for INFORMAL papers which do not need to be entered into the case file)

Please note the changed number for informal faxes: it is the same as my voice number, which can also now handle fax transmissions and ensures I receive your fax immediately.

My email address is:

john.paradiso@uspto.gov

**Notification of Non-Compliance with  
37 CFR 1.192(c)**

Application No.

08/833,342

Applicant(s)

MAA

Examiner

John Paradiso

Group Art Unit

3713



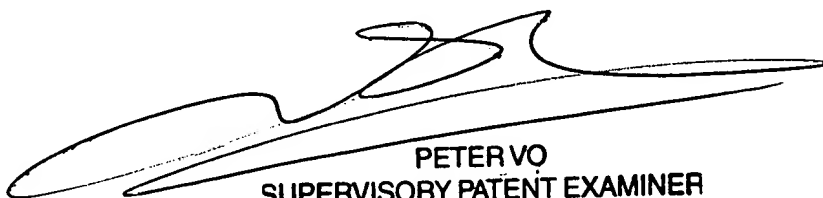
The Appeal Brief filed on 6/6/00 is defective for failure to comply with one or more provisions of 37 CFR 1.192(c). See MPEP § 1206.

Applicant is given a TIME LIMIT of ONE MONTH from the date of this letter or any time remaining in the period under 37 CFR 1.192(a) for filing a new complete brief. If a new brief that fully complies with 37 CFR 1.192(c) is not timely submitted, the appeal will be dismissed. The new complete brief must be filed IN TRIPLICATE. See 37 CFR 1.192(a).

1. ☐ The brief does not contain the items required under 37 CFR 1.192(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, pending or cancelled, or does not identify the appealed claims (37 CFR 1.192(c)(3)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 1.192(c)(4)).
4. ☐ The brief does not contain a concise explanation of the claimed invention, referring to the specification by page and line number and to the drawing, if any, by reference characters (37 CFR 1.192(c)(5)).
5. ☐ The brief does not contain a concise statement of the issues presented for review (37 CFR 1.192(c)(6)).
6. ☐ A single ground of rejection has been applied to two or more claims in this application, and
  - a. ☐ the brief omits the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet presents arguments in support thereof in the argument section of the brief.
  - b. ☐ the brief includes the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet does not present arguments in support thereof in the argument section of the brief.
7. ☐ The brief does not present an argument under a separate heading for each issue on appeal (37 CFR 1.192(c)(8)).
8. ☒ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 1.192(c)(9)).
9. ☒ Other (including any explanation in support of the above items):

*Applicant has filed an after-final amendment which has been entered (Applicant was informed of this via Advisory Action, Paper No. 27). A new Appeal Brief must be filed with an updated Appendix, reflecting the new state of the claims.*

*Paradiso, Examiner*

  
PETER VO  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700

**EXHIBIT B**

833342

# NOTICE OF DRAFTPERSON'S PATENT DRAWING REVIEW

The drawing filed (insert date) 4/4/97 are:

A. X not objected to by the Draftperson under 37 CFR 1.84 or 1.152.

B.        objected to by the Draftperson under 37 CFR 1.84 or 1.152 as indicated below. The Examiner will require submission of new, corrected drawings where necessary. Corrected drawings must be submitted according to the instructions on the back of this notice.

## 1. DRAWINGS. 37 CFR 1.84(a): Acceptable categories of drawings:

Black ink. Color.

       Color drawing are not acceptable until petition is granted.

Fig.(s)       

       Pencil and non black ink is not permitted. Fig(s)       

## 2. PHOTOGRAPHS. 37 CFR 1.84(b)

       Photographs are not acceptable until petition is granted,

       3 full-tone sets are required. Fig(s)       

       Photographs not properly mounted (must bristol board or photographic double-weight paper). Fig(s)       

       Poor quality (half-tone). Fig(s)       

## 3. TYPE OF PAPER. 37 CFR 1.84(e)

       Paper not flexible, strong, white and durable.

Fig.(s)       

       Erasures, alterations, overwritings, interlineations, folds, copy machine marks not acceptable. (too thin)

       Mylar, vellum paper is not acceptable (too thin).

Fig(s)       

## 4. SIZE OF PAPER. 37 CFR 1.84(f): Acceptable sizes:

       21.0 cm by 29.7 cm (DIN size A4)

       21.6 cm by 27.9 cm (8 1/2 x 11 inches)

       All drawings sheets not the same size.

Sheet(s)       

## 5. MARGINS. 37 CFR 1.84(g): Acceptable margins:

Top 2.5 cm Left 2.5 cm Right 1.5 cm Bottom 1.0 cm

SIZE: A4 Size

Top 2.5 cm Left 2.5 cm Right 1.5 cm Bottom 1.0 cm

SIZE: 8 1/2 x 11

       Margins not acceptable. Fig(s)       

       Top (T)        Left (L)

       Right (R)        Bottom (B)

## 6. VIEWS. CFR 1.84(h)

REMINDER: Specification may require revision to correspond to drawing changes.

       Views connected by projection lines or lead lines.

Fig.(s)       

Partial views. 37 CFR 1.84(h)(2)

       Brackets needed to show figure as one entity.

Fig.(s)       

       Views not labeled separately or properly.

Fig.(s)       

       Enlarged view not labeled separately or properly.

Fig.(s)       

## 7. SECTIONAL VIEWS. 37 CFR 1.84(h)(3)

       Hatching not indicated for sectional portions of an object.

Fig.(s)       

       Sectional designation should be noted with Arabic or

Roman numbers. Fig.(s)       

## 8. ARRANGEMENT OF VIEWS. 37 CFR 1.84(i)

       Words do not appear on a horizontal, left-to-right fashion when page is either upright or turned, so that the top becomes the right side, except for graphs. Fig(s)       

       Views not on the same plane on drawing sheet. Fig(s)       

## 9. SCALE. 37 CFR 1.84(k)

       Scale not large enough to show mechanism with crowding when drawing is reduced in size to two-thirds in reproduction.

Fig.(s)       

## 10. CHARACTER OF LINES, NUMBERS, & LETTERS. 37 CFR 1.84(l)

       Lines, numbers & letters not uniformly thick and well defined, clean, durable and black (poor line quality).

Fig.(s)       

## 11. SHADING. 37 CFR 1.84(m)

       Solid black areas pale. Fig.(s)       

       Solid black shading not permitted. Fig.(s)       

       Shade lines, pale, rough and blurred. Fig(s)       

## 12. NUMBERS, LETTERS, & REFERENCE CHARACTERS.

37 CFR 1.48(p)

       Numbers and reference characters not plain and legible.

Fig.(s)       

       Figure legends are poor. Fig.(s)       

       Numbers and reference characters not oriented in the same

direction as the view. 37 CFR 1.84(p)(3) Fig.(s)       

       English alphabet not used. 37 CFR 1.84(p)(3) Fig.(s)       

       Numbers, letters and reference characters must be at least

.32 cm (1/8 inch) in height. 37 CFR 1.84(p)(3) Fig.(s)       

## 13. LEAD LINES. 37 CFR 1.84(q)

       Lead lines cross each other. Fig.(s)       

       Lead lines missing. Fig.(s)       

## 14. NUMBERING OF SHEETS OF DRAWINGS. 37 CFR 1.48(t)

       Sheets not numbered consecutively, and in Arabic numerals beginning with number 1. Fig.(s)       

## 15. NUMBERING OF VIEWS. 37 CFR 1.84(u)

       Views not numbered consecutively, and in Arabic numerals, beginning with number 1. Fig.(s)       

## 16. CORRECTIONS. 37 CFR 1.84(w)

       Corrections not made from PTO-948 dated       

## 17. DESIGN DRAWINGS. 37 CFR 1.152

       Surface shading shown not appropriate. Fig.(s)       

       Solid black shading not used for color contrast.

Fig.(s)       

## COMMENTS

REVIEWER

A. Doan

DATE

8/20/97

TELEPHONE NO.

703 3058404

ATTACHMENT TO PAPER NO.       

PTO COPY

Account Number  
817-277-9081-687-0  
July 13, 1999



Page 9 of 12

Billing For:  
AT&T

<b>► Current Charges</b>		
Monthly Service (See Item 1)		4.95
Other Charges (See Items 2 and 3)		2.50
Itemized Calls (See Items 4 thru 78)		22.10
Surcharges (See Items 79 and 80)		.61
		<hr/>
<b>► AT&amp;T Current Charges (before taxes)</b>		<b>30.16</b>
Federal Tax	.91	
State and Local Taxes	1.98	

AT&T  
Billing Questions:  
1-800-222-0300

**For Your Information**

AT&T Invoice Charges, Period Ending JUL 06, 1999

You may notice increases in the Universal Connectivity Charge and the Carrier Line Charge beginning in July. For current information on these charges please call 1 800 532-2021.

Monthly Service	Item	Explanation	Amount
	1	AT&T One Rate (R) Plus Plan JUL 06 thru AUG 05	4.95
	<b>► AT&amp;T Total Monthly Service (before taxes)</b>		<b>4.95</b>

Other Charges	Item	Explanation	Amount
	2	Universal Connectivity Charge For an explanation of this charge, please call 1 800 532-2021	.99
	3	Carrier Line Charge For an explanation of this charge, please call 1 800 532-2021	1.51
	<b>► AT&amp;T Total Other Charges (before taxes)</b>		<b>2.50</b>

Itemized Calls	Item	Date	Time	Place Called	Area	Number	Rate*	Min	Amount
AT&T Calls for 817-277-9081									
	4	06/07	02:02PM	PITTSBURGH	PA	412 281-6057	D	1	.10 %
	5	06/07	03:05PM	PITTSBURGH	PA	412 281-6057	D	1	.10 %
	6	06/08	09:20AM	PITTSBURGH	PA	412 281-6057	D	1	.10 %
	7	06/08	09:22AM	PITTSBURGH	PA	412 343-7427	D	6	.60 %
	8	06/10	07:51PM	ALEXANDRIA	VA	703 305-3579	D	1	.10 %
	9	06/10	07:54PM	MICHIGNBAR	CA	916 314-8644	D	1	.10 %
	10	06/10	10:18PM	MICHIGNBAR	CA	916 314-8644	D	1	.10 %
	11	06/11	09:04AM	MICHIGNBAR	CA	916 314-8644	D	1	.10 %
	12	06/11	09:09AM	PITTSBURGH	PA	412 531-1200	D	1	.10 %
	13	06/11	09:10AM	PITTSBURGH	PA	412 281-6057	D	1	.10 %
	14	06/11	09:11AM	PITTSBURGH	PA	412 343-7427	D	1	.10 %
	15	06/11	09:25AM	CINCINNATI	OH	513 772-7788	D	4	.40 %
	16	06/11	01:32PM	CINCINNATI	OH	513 772-7788	D	2	.20 %
	17	06/11	10:40PM	ALEXANDRIA	VA	703 305-3579	D	19	1.90 %
	18	06/11	10:59PM	ALEXANDRIA	VA	703 305-3579	D FX	19	1.90 %
	19	06/12	03:12PM	MICHIGNBAR	CA	916 314-8644	D	3	.30 %
	20	06/15	12:41AM	ALEXANDRIA	VA	703 305-3579	D FX	8	.80 %
	21	06/15	09:33AM	ALEXANDRIA	VA	703 308-2825	D PH	2	.20 %
	22	06/15	10:10AM	ALEXANDRIA	VA	703 308-2825	D PH	1	.10 %
	23	06/15	10:14AM	ALEXANDRIA	VA	703 308-2668	D PH	1	.10 %

Received from

AT&T

**EXHIBIT D**

Account Number  
817-277-9081-687-0  
July 13, 1999

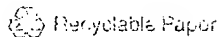


Page 10 of 12

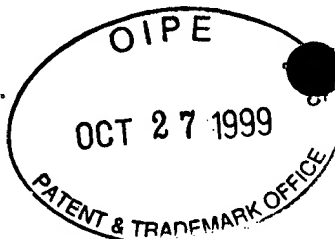
Itemized Calls  
(Continued)

Item	Date	Time	Place Called	Area	Number	Rate*	Min	Amount
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25	06/15	11:03AM	CINCINNATI	OH	513 772-7788	D	2	.20 %
26	06/15	11:14AM	ALEXANDRIA	VA	703 308-2825	D PR	1	.10 %
27	06/16	08:34AM	ALEXANDRIA	VA	703 308-4987	D	1	.10 %
28	06/16	11:29AM	MICHIGNBAR	CA	916 314-8644	D	2	.20 %
29	06/16	12:50PM	ALEXANDRIA	VA	703 308-2825	D PR	1	.10 %
30	06/16	12:51PM	ALEXANDRIA	VA	703 308-4987	D	1	.10 %
31	06/16	12:53PM	ALEXANDRIA	VA	703 308-4987	D	1	.10 %
32	06/16	01:26PM	ALEXANDRIA	VA	703 308-2825	D PR	5	.50 %
33	06/16	02:13PM	ALEXANDRIA	VA	703 308-7768	D FX	7	.70 %
34	06/16	02:38PM	DALLAS	TX	214 855-7571	N	2	.30 i
35	06/16	03:35PM	DALLAS	TX	214 855-7500	N	2	.30 i
36	06/16	03:37PM	DALLAS	TX	214 880-7626	N	1	.15 i
37	06/16	03:38PM	DALLAS	TX	214 855-7571	N	15	2.25 i
38	06/16	04:33PM	DALLAS	TX	214 855-7571	N	1	.15 i
39	06/17	10:21AM	CINCINNATI	OH	513 772-7788	D	4	.40 %
40	06/17	10:35AM	ALEXANDRIA	VA	703 308-2668	D	1	.10 %
41	06/17	02:07PM	ALEXANDRIA	VA	703 308-2668	D	1	.10 %
42	06/17	02:08PM	ALEXANDRIA	VA	703 308-2668	D	1	.10 %
43	06/17	02:27PM	ALEXANDRIA	VA	703 308-2668	D	8	.80 %
44	06/17	02:35PM	ALEXANDRIA	VA	703 308-6789	D	4	.40 %
45	06/18	09:25AM	ALEXANDRIA	VA	703 308-6789	D	5	.50 %
46	06/18	09:30AM	ALEXANDRIA	VA	703 308-3663	D	2	.20 %
47	06/18	09:31AM	ALEXANDRIA	VA	703 308-3663	D	2	.20 %
48	06/18	09:32AM	ALEXANDRIA	VA	703 308-1113	D	4	.40 %
49	06/18	09:36AM	ALEXANDRIA	VA	703 308-2569	D	1	.10 %
50	06/18	03:04PM	ALEXANDRIA	VA	703 308-2569	D	1	.10 %
51	06/19	05:53PM	WILLOWS	CA	530 685-6655	D	1	.10 %
52	06/20	11:41PM	GREENSBURG	PA	724 837-8731	N	2	.10 %
53	06/20	11:48PM	TARPON SPG	FL	727 934-2390	N	3	.15 %
54	06/20	11:52PM	SAN MATEO	CA	650 373-3076	N	2	.10 %
55	06/20	11:57PM	MEMPHIS	TN	901 754-2896	N	2	.10 %
56	06/21	12:07AM	HOUSTON	TX	713 624-8030	N	2	.30 i
57	06/23	01:28PM	ALEXANDRIA	VA	703 308-2825	D PR	1	.10 %
58	06/23	02:50PM	ALEXANDRIA	VA	703 308-2825	D PR	1	.10 %
59	06/23	02:57PM	ALEXANDRIA	VA	703 308-2825	D PR	1	.10 %
60	06/23	02:59PM	DALLAS	TX	214 855-7500	N	4	.60 i
61	06/23	03:17PM	HOUSTON	TX	713 624-8030	N	1	.15 i
62	06/23	03:17PM	REDWOOD CY	CA	650 599-9904	D	3	.30 %
63	06/23	03:22PM	DALLAS	TX	214 855-7500	N	2	.30 i
64	06/23	03:29PM	ALEXANDRIA	VA	703 308-2825	D	4	.40 %
65	06/24	08:16AM	ALEXANDRIA	VA	703 308-2825	D	1	.10 %
66	06/24	08:17AM	ALEXANDRIA	VA	703 308-2825	D	1	.10 %
67	06/28	10:56AM	ALEXANDRIA	VA	703 308-7768	D FX	7	.70 %
68	06/28	11:06AM	ALEXANDRIA	VA	703 308-3663	D	4	.40 %
69	07/04	06:39PM	MICHIGNBAR	CA	916 314-8644	N	1	.05 %
70	07/04	06:40PM	MICHIGNBAR	CA	916 314-8644	N	1	.05 %
71	07/04	06:54PM	MICHIGNBAR	CA	916 314-8644	N	1	.05 %
72	07/04	06:55PM	MICHIGNBAR	CA	916 314-8644	N	1	.05 %
73	07/04	06:56PM	MICHIGNBAR	CA	916 314-8644	N	1	.05 %
74	07/04	07:11PM	MICHIGNBAR	CA	916 314-8644	N	1	.05 %
75	07/04	07:12PM	WILLOWS	CA	530 685-6655	N	1	.05 %

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See Back of Page



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/833,342	04/04/97	MAA	S 3807.2US

SHALONG MAA, PH.D., PRESIDENT  
SMA INTERNATIONAL, INC.,  
816 MCDEAVITT DRIVE, #1077  
ARLINGTON TX 76011

QM12/0802

EXAMINER

PARADISO, J

ART UNIT	PAPER NUMBER
----------	--------------

3713

DATE MAILED: 08/02/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**EXHIBIT A**



# Office Action Summary

Application No.  
08/833,342

Applicant(s)  
MAA

Examiner  
John Paradiso

Group Art Unit  
3713



☒ Responsive to communication(s) filed on Jul 2, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 35-60 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 35-60 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3721

## DETAILED ACTION

### Continued Prosecution Application

1. The request filed on 5/10/99 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/831,342 is acceptable and a CPA has been established. An action on the CPA follows.

### Examiner's Amendment

2. An Examiner's Amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this Examiner's Amendment was given in a telephone interview with Dr. Shalong Maa on July 19, 1999.

3. The application has been amended as follows:
  - a) Claims 1-28 have been canceled.
  - b) Claims numbered 1-26, submitted on 7/2/99 as a Preliminary Amendment and entered as Paper # 13, have been renumbered as claims 35-60

Art Unit: 3721

Papers Entered

4. A revocation of Power of Attorney was entered 6/11/99 as Paper No. 8 and Applicant is now administering the application *pro se*.
5. The following papers were entered on 7/2/99 as Paper No. 13:
  - A substitute Specification
  - A Preliminary Amendment, including 26 claims
  - Remarks
6. For Applicant's convenience, any future changes to the Specification may be made by submitting an amendment indicating the page and location of any words to be amended, deleted, or added.

When submitting an amendment to a claim, the label "(amended)" should be typed after the claim number and the entire claim must be quoted as it appears on the record. Any additions must then be inserted and underlined; any deletions must be placed within square brackets.

Art Unit: 3721

*Claim Rejections - 35 USC § 112*

7. Claim 42 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 42 lines 2-3, it is unclear what is meant by "means for transferring said external .. signal .. to a drive-control signal sequence..". It would appear that a signal can be transferred to a means for receiving it, not another sequence.

*Claim Rejections - 35 USC § 102*

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 35, 37, and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by TONG.

Art Unit: 3721

TONG discloses an interactive, computer-controlled doll, as described in the previous Office Action, in which actuators to move the doll's body parts. TONG discloses providing a signal from the computer to the doll, which in turn moves the appropriate parts of the doll (mouth, arms, etc.) depending on whether the signal is present or not. Note that while the information within the signal is analog data, the dolls actuators respond to the presence or lack of the signal, taking not the audio data within, but the presence of the signal itself as a logic signal.

TONG also discloses (in embodiment in Fig. 6) a voice-recognition feature where the user can speak into a microphone and the computer will recognize the words and provide the appropriate signal(s) to the doll.

(See TONG columns 2-4 and figures 1 and 6.)

*Claim Rejections - 35 USC § 103*

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3721

11. Claims 36 and 38-4 are rejected under 35 U.S.C. §103(a) as being unpatentable over TONG.

TONG discloses the claimed invention except for the actuators being comprised of a "solenoid means".

✓ However, Applicant is given Official Notice that the use of solenoids as actuators for the movement of dolls and figures is well known in the art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to connect two-phase solenoids as the actuators in the invention of TONG in order to reduce the complexity and cost of the actuators and the invention.

12. Claims 44-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over TONG as applied to claims 36 and 38 above, and further in view of GASPER ET AL.

TONG substantially discloses the claimed invention except for specifically describing the "digital animation-control signal sequence being associated with selected audio speech ... and transmitted to the toy in synchronization with the transmission".

✓ GASPER ET AL discloses a system for sound-synchronized animation for use in a game, as described in the previous Office Action. GASPER ET AL builds and saves its own dictionary file after determining the proper lip synchronization of an inputted

Art Unit: 3721

word. GASPER ET AL also teaches different articulations for various sounds: silence, vowels, and consonants.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the method of sound analysis used in GASPER ET AL in the invention of TONG in order to efficiently and accurately analyze and coordinate the inputted user sounds with the movement signals sent to the doll of TONG.

Examiner also notes that TONG does disclose the use of voice-recognition software to analyze inputted voice data. Examiner also notes that it is a standard programming technique to store inputted data of all types, including voice recognition data, in memory arrays for temporary use and in text files for permanent storage and later retrieval.

Art Unit: 3721

*Response to Remarks*

13. Applicant's arguments filed 7/2/99 have been fully considered but they are not persuasive.

14. Applicant states on page 2 of his Remarks that "Tong utilizes a computer to only send an analog signal to the toy."

However, as explained above, TONG discloses providing a signal from the computer to the doll, which in turn moves the appropriate parts of the doll (mouth, arms, etc.) depending on whether the signal is present or not. Note that while the information within the signal is analog data, the dolls actuators respond to the presence or lack of the signal, taking not the audio data within, but the presence of the signal itself as a logic signal.

15. Applicant states on page 4 of his Remarks that TONG does not employ "an actuator having only two phases for moving said movable portion".

However, the solenoids described in paragraph 12 above do indeed inherently have two phases for moving a movable portion.



Art Unit: 3721

16. Applicant states on page 5 of his Remarks that "Gasper does not disclose means for adjusting the frequency of the image-actuation control according to the reaction or response time of the moveable portion of the on-screen image..".

However, the claims do not recite adjusting the frequency of the image-actuation control in that manner.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to:

**VALENCIA MARTIN-WALLACE  
PRIMARY EXAMINER**



Examiner John Paradiso  
Telephone: (703) 308-2825  
Fax: (703) 305-3579/3580

July 29, 1999

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Maa, Shalong

Application No.: 08/833,342

Art Unit: 3713

Filing Date: April 4, 1997

For: Computer-Controlled Talking Figure Toy with Animated Features

Assistant Commissioner for Patents  
Box Action-Reply (Non-Fee Amendment )  
Washington, D.C. 20231

Dear Examiner:

REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. §1.111

In response to the Office Action dated August 02, 1999, Applicant hereby submits the following remarks and request for reconsideration without amendment.

---

CERTIFICATION UNDER 37 C.F.R. 1.18(a), 1.1.0

I hereby certify that, on the day shown below, this correspondence is being:

- ☒ Deposited with the United Postal Service in an envelope addressed to : Assistant Commissioner of Patents, Washington, D.C. 20231
- ☐ Mailing with sufficient postage as first class mail.
- ☒ Mailing as "Express Mail Post Office to Addressee", Mailing No. EK025180847US
- ☐ Transmitted by facsimile to the Patent and Trademark Office.

Signature

Shalong Maa  
(Type or print name of person certifying)

Date: 10/27/99

EXHIBIT E

REMARKS AND ARGUMENTS

Applicant respectfully requests reconsideration of Application in view of the following remarks and with reference to Claims and remarks submitted on July 4, 1999. Applicant confirm the canceling of Claims 1-28 originally presented, and renumbering of newly submitted Claims as 35-60. Therefore, current four (4) independent pending Claims so numbered are, respectively, 35, 37, 44, and 51 which, together with those dependent therefrom, stand rejected. Accordingly, Claims 35-60 are presented for further consideration without amendment thereto.

I. CORRECTION OF THE OFFICE ACTION

During telephone conversations with Mr. J. Paradiso (Examiner) on 09/24/99 and 10/13/99 and with Ms. V. Wallace (Supervisory Examiner) on 10/12/99, an error on the "Office Action Summary" page of the Action dated August 02, 1999 has been pointed out. Applicant has not yet received written confirmation for correction thereof. More errors have been found in said Office Action after further review by Applicant. Therefore, Applicant respectfully requests confirmation and correction of the following typographical or clerical errors so uncovered pursuant to 37 C.F.R. § 1.111(b):

- (0.1) Checked Box for indicating *"This action is FINAL"* (2nd line of the middle box on Page 1, or the front "Office Action Summary" page), which is incorrect, as the parties agreed during said telephone conversations on 09/24/99, 10/12/99, and 10/13/99.
- (0.2) "...*patent Application No. 08/831,342*" (2nd line of Section 1 on Page 2), which should be "...*patent Application No. 08/833,342*"
- (0.3) "*Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312*" (3rd line of Section 2 on Page 2), which, APPLICANT believe, is incorrect, since the 37 CFR § 1.312 is provided for "Amendments after Allowance"
- (0.4) "*b) Claims numbered 1-26, submitted on 7/2/99 as a Preliminary Amendment ..*" (3rd line of Section 3 on Page 2), wherein, the term "preliminary" is incorrect, since the term "formal" is shown at the front page of said submission; and wherein, the date is incorrect, since APPLICANT's record shows that the new Claims were submitted on 7/4/99, a Federal holiday, and the date stamped thereon shall be the next succeeding business day. (37 CFR § 1.6(a)(3)).

- (0.5) "*The following papers were entered on 7/2/99 as..*" (1st line of Section 5 on Page 3), wherein the date is incorrect. (See subsection (0.4) hereinabove)
- (0.6) "*Claims 36 and 38-4 are rejected ...*" (1st line of Section 11 on Page 6), wherein the Claim number "38-4" is certainly incorrect.
- (0.7) "Applicant's arguments filed 7/2/99....." (1st line of Section 13 on Page 8), in which, again, the date is incorrect (see subsection (0.4) hereinabove).
- (0.8) The stamp\* showing "*Valencia Martin-Wallace, Primary Examiner*" ( Lower right portion of Page 9)

## Note:

- \* According to the one-time tele-conference with Ms. Valencia Martin-Wallace on October 12, 1999 , it was apparent to Applicant that Ms. Wallace is the Supervisory Examiner of the group, and was not acting as a Primary Examiner for the present application.

## II. REJECTION UNDER 35 U.S.C. § 102(b) and 103(a)

- (1) (1.1) Applicant respectfully traverses the rejection of Claims 35, 37, and 43, as being anticipated by Tong, under 35 U.S.C. § 102(b) which required that the prior art invention was patented "more than one year prior to the date of the application.." The non-provisional application filing date of the present case is April 4, 1997, which is more than two month earlier than the patent date of TONG; and the provisional application filing date is April 5, 1996, which is fourteen month earlier than TONG's patent date.

(1.2) In addition, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

(1.3) Applicant also traverses the rejection of Claims 36, 38, and 44-60 as being unpatentable over TONG under 35 U.S.C. § 103(a), as explained in GROUND OF TRAVERSE section

- (2) Applicant have noticed that most of the arguments in the Office Action dated 08/02/99 (hereinafter "ACTION") are identical to the previous Office Action dated 11/10/99 (hereinafter

"PREVIOUS ACTION"), and there is no new ground of rejection provided in the ACTION. In order for Applicant to properly reply to the ACTION under 37 C.F.R. § 1.111(b), Comparison between the ACTION and the PREVIOUS ACTION is shown as follows:

(2.1) The first paragraph of Page 5 (under Section No. 9) of the ACTION is the same as the last paragraph of Page 3 (under Section No. 4) of the PREVIOUS ACTION except for the added phrase *"in which actuators to move the doll's body parts"* (2nd line);

(2.2) The second paragraph of Page 5 (under Section No. 9) of the ACTION is identical to the first paragraph of Page 4 (under Section No. 4) of the PREVIOUS ACTION;

(2.3) The third paragraph of Page 6 (under Section No. 11) of the ACTION is the same as the second paragraph of Page 6 (under Section No. 5) of the PREVIOUS ACTION except for the first word *"However"* in place of the phrase *"Regarding claims 15, 16, 26, and 27"*;

(2.4) The last paragraph of Page 6 (under Section No. 12) of the ACTION is identical to the third paragraph of Page 5 (under Section No. 5) of the PREVIOUS ACTION;

(2.5) The last paragraph of Page 7 (under Section No. 12) of the ACTION is identical to the last paragraph of Page 5 (under Section No. 5) of the PREVIOUS ACTION;

(2.6) The third paragraph of Page 8 (under Section No. 14) of the ACTION is substantially identical to the last paragraph of Page 6 (under Section No. 7) of the PREVIOUS ACTION.

(2.7) Applicant have also recognized that the arguments described hereinabove in this section are completely irrelevant to the newly presented Claims 35-60. Therefore, unless Examiner provides evidence proving to the contrary, Applicant concludes that the ACTION is a falsified document, which is also supported by Section (3) hereinbelow. Examiner's lack of response hereto would render his/her agreement hereupon.

(3) In the ACTION, as Applicant have noticed, section 7 on Page 4, section 15 on Page 8, and section 16 on Page 9 are the only three argument sections with discussions therein not found in the PREVIOUS ACTION. However,

(3.1) the only argument of said section 15 on Page 8 is making a reference to another section or paragraph;

(3.2) in said Section 16 on Page 9, Examiner's only argument is *"However, the claims do not recite adjusting the frequency of the image-actuation control in that matter"*; such an argument is completely irrelevant to any of the Claims, since *"frequency of the image-actuation control in that*

*matter* does not belong to any part of the subject matter of the present invention;

(3.3) In said Section 7 on Page 4, Examiner states : "*In Claim 42 lines 2-3, it is unclear what is meant by 'means for transferring said external...signal..to a drive-control signal sequence ..'*";

Nevertheless, the discussion of digital-signal transfer can be found in the specification;

(3.4) As described hereinabove, arguments in all other sections of the ACTION are essentially the same as the PREVIOUS ACTION.

(3.5) Therefore, Applicant concludes, and vehemently object to, that Examiner has, in the ACTION, ignored and is completely unresponsive to Applicant's newly submitted Claims and arguments.

(3.6) "The examiner's action will be complete as to all matters" (37 C.F.R. § 104(b) ). The discussions in Section (2-3) herein shows that in the ACTION, Examiner does provided ground of rejection for each and every claim rejected, and have ignored most matters set forth in newly submitted Claims (35-60). Therefore, Applicant concludes that the ACTION, or the Office Action dated 08/02/99, is incomplete. Examiner's lack of response hereto would render his/her agreement hereupon.

### III. GROUND OF TRAVERSE

Again, Applicant traverses all rejections of Claims, under 35 U.S.C. § 103, as being unpatentable over TONG and/or in further view of GASPER et al, with ground thereof further explained, in reference to Claims 34-60 and Remarks submitted on 07/04/99 (hereinafter "REMARKS"), as follows:

#### (4) Non-analogous Art

(4.1) "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986);

(4.2) According to Sections 1 and 4 of the REMARKS, and to preambles of Claims 35, 37, and 44 and the background and summary sections of the specification, TONG is not pertinent to such particular problem, with which the present invention is concerned, as to provide a toy figure

that is "responsive to receiving an external digital animation-control signal sequence...", instead of reacting to receiving an analog signal from a computer.

(4.3) With regard to evidence of "nonanalogy", the court has found "the similarities and differences in structure and function of the inventions to carry far greater weight." In re Ellis, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973). Therefore, arguments in Section (5) hereinbelow is a showing that both TONG and GASPER are non-analogous references.

(4.4) Pursuant to 37 C.F.R. § 1.104 ( c ), Applicant respectfully request that Examiner clearly describe the pertinence of each reference, and clearly explain each rejected claim.

(5) Different Structures and Functions

(5.1) Structural differences between the present invention and said prior art references are apparent when comparing the newly submitted Claims 35-60 with prior art Claims. Said comparison also illustrates functional differences therebetween. Additionally, in Sections 5-9 of the REMARKS, Applicant has provided extensive description of new and different functions of the present inventions.

(5.2) Examiner have ignored and is unresponsive to almost all points of arguments in the REMARKS, as described in Section (2-3) hereinabove, which is a showing that Examiner agrees with said arguments. However, **Applicant respectfully requests, and insists, that Examiner explicitly addresses (either agree or point out the exact portion that he/she is opposed to), in the ensuing Office Action, each and every point of argument herein and in the REMARKS regarding said differences.**

(5.3) Therefore, the aforesaid new and different functions, as well as said structural differences, of the present invention render its non-obviousness, which is evidenced by the Court decisions in both the Sakraida v. Ag Pro, Inc., 425 U.S. 273, 189 USPQ 449, reh'g denied, 426 U.S. 955 (1976) and Anderson's-Black Rock, Inc. v. Pavement Salvage Co., 396 U.S. 57, 163 USPQ 673 (1969).

(6) Claim Limitations Not Being Taught or Suggested in Prior Art

(6.1) In order to constitute prima facie obviousness of an invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

(6.2) Furthermore, if an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is non-obvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

(6.3) In present case, TONG and GASPER certainly do not teach nor suggest all Claim Limitations of the present application.

(7) Proposed Modification Not Feasibility

(7.1) If alleged modification would render functions of the prior art invention being modified unfeasible or unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

In present case, (7.2) not only the prior art references do not have the same purposes as the present invention, as described in section (4) hereinabove; (7.3) the alleged combination by the examiner for obtaining results or effects of the present invention is not functional feasible, as described in Sections 8-9 of the REMARKS.

(7.4) Furthermore, It is not feasible to simply changed the DC motor of TONG to a solenoid, because the electronic driving system provided therein can not be used to control a solenoid, which is obvious to one having ordinary skill in the art.

(8) Superiority of Properties; Absence of Prior Art Properties

As described in the REMARKS, the present invention possesses several functions and properties that are clearly superior to the prior art inventions, including, but not limited to,

(8.1) Movement of toy's second body part being independent of that of the first body part so as to be realistic, instead of all said body parts being moving concurrently and dependently; which can also be understood as absence of the property of said concurrent and dependent moving in the present invention based on the teachings of the prior art.

(8.2) Toy figure being responsive to receiving digital animation-control signal;

(8.3) Accurate control of movement of toy figure's mouth according to detailed textual content of the doll's speech, such as arrangement of vowel letters therein;

(8.4) Controlling the movement of toy figure's body part without presence or input of any sound signal;

(8.5) Selectively activating toy figure's body part according to user's demand instead of



being solely controlled by the amplitude of the sound signal input, which can also be understood as absence of the property of said solely controlling in the present invention based on the teachings of the prior art;

(8.6) It is understood that presence of a superior property or property not possessed by the prior art or unexpected or greater than expected result are evidence of non-obviousness. In re Corkill, 711 F.2d 1496, 226 USPQ 1005 (Fed. Cir. 1985); Papesch, 315 F.2d 381, 137 USPQ 43 (CCPA 1963); Chupp, 816 F.2d 643, 646, 2 USPQ2d 1437, 1439 (Fed. Cir. 1987); See also Ex parte Thumm, 132 USPQ 66 (Bd. App. 1961); Merck & Co. Inc. v. Biocraft Laboratories Inc., 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989).

(8.7) In addition, absence of a property which the present invention would have been expected to possess based on the teachings of the prior art also renders unobviousness of the invention. Ex parte Mead Johnson & Co. 227 USPQ 78 (Bd. Pat. App. & Inter. 1985)

(9) Subject Matter as a Whole (35 U.S.C. § 103)

In previous two Office Actions, Examiner particularly point out the use of solenoid as being "obvious". However,

(9.1) "In determining whether the invention as a whole would have been obvious under 35 U.S.C. 103, we must first delineate the invention as a whole. In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question... but also to those properties of the subject matter which are inherent in the subject matter and are disclosed in the specification..... it is this invention as a whole, and not some part of it, which must be obvious under 35 USC 103." In re Antonie, 559 F.2d 618, 620, 195 USPQ 6,8 (CCPA 1977); see also Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); Schenck v. Nortron Corp., 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983)

(9.2) Furthermore, solenoid is not a commonly used device for actuating moving part of a doll in the toy industry, as described in Section (11) hereinbelow.

(10) Lack of Suggestion or Motivation to Modify the References:

(10.1) Applicant agree that the invention of TONG can be modified. However, in order to obtain all the results of the present invention, such modification needs to be substantial, i.e., (a) the entire internal structure and arrangement of the toy figure of TONG needs to be changed, and (b) the

computer software program also needs to be replaced.

(10.2) Furthermore, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Neither TONG nor GASPER teaches said suggestion or desirability.

(11) Lack of Success of Others (Secondary Considerations)

(11.1) According to Applicant's experience and observation, solenoid is not a commonly used device for actuating moving mouth of a doll in the toy industry; In fact Applicant does not notice any product of this type currently exists in the market; Other than one of the prior art references (NOLL) recited in the Office Action dated 04/30/98, Examiner has not yet provide evidence of any kind (such as name and manufacture of a product), for proving to the contrary.

(11.2) There is still no product in the market that is similar to the present invention which was invented more than three years ago.

(11.3) Therefore, there is no evidence for supporting reasonable expectation of success for the proposed modification by the Examiner at the time present invention was made, which apparently substantiate the conclusion that present invention is nonobvious. In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976).

IV. ENSUING OFFICE ACTION; REQUEST

(12) Ground of Rejection - General

Applicant respectfully request that in determine the obviousness or non-obviousness matters of the present invention, Examiner relies upon the Graham three pronged test. The Supreme Court in Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under Section 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquires may have relevancy. . .

(13) Response to All Arguments

(13.1) Each and every section and subsection herein has been carefully labeled in numerical or alphabetic order for the convenience of Examiner. All Section of the REMARKS submitted on 07/04/99 are also labeled.

(13.2) Applicant respectfully requests, and insists, that Examiner explicitly addresses (either agree or point out the exact portion that he/she is opposed to), in the ensuing Office Action, each and every point of argument in this Remarks and Arguments and in the previously submitted REMARKS. (Repeat).

(13.3) Lack of response to any argument herein or in the REMARKS will render examiner's agreement with said agreement.

(13.4) Applicant respectfully request that Examiner do not present conflict argument resulting said lack of response.

(14) Ground of Rejection -Legal Precedent

(14.1) Applicant has provided Legal Precedent in support the arguments herein, and respectfully request that Examiner do the same should he/she is opposed to any of said arguments.

(14.2) "The value of the exceedingly large body of precedent wherein our predecessor courts and this court have applied the law of obviousness to particular facts, is that there has been built a wide spectrum of illustrations and accompanying reasoning, that have been melded into a fairly consistent application of law to a great variety of facts." In re Eli Lilly & Co., 902 F.d. 943, 14 USPQ2d 1741 (Fed. Cir. 1990).

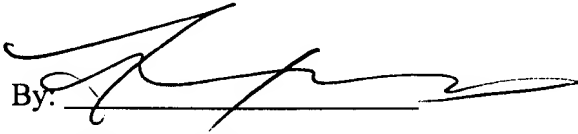
V. CONCLUSION

(15) For the foregoing reasons, reconsideration of the application, as submitted on 07/04/99, including a substitute specification and new Claims 35-60, without amendment thereto, pursuant to 37 C.F.R. § 1.112, is respectfully requested.

Should any fee be due with respect to this filing, please inform the examiner in writing at the address hereinbelow.

Respectfully submitted,

S.M.

By: 

Shalong Maa, Ph.D.

October 27, 1999

SMA International, Inc.  
816 McDeavitt Dr., 1077  
Arlington, TX 76011  
(817) 277-9081